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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91216969
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE
TRADEMARK TRIAL AND APPEAL BOARD**

In re U.S. Trademark Application Serial No. 86/127,398 for “SEBELA” filed on November 22, 2013 and Published in the *Official Gazette* on April 22, 2014

FOREST LABORATORIES, LLC,)	
)	
Opposer,)	OPPOSITION NO.: 91216969
)	
v.)	
)	
)	
SEBELA INTERNATIONAL LIMITED,)	
)	
)	
Applicant.)	

Pursuant to Rule 56 of the Federal Rules of Civil Procedure and T.B.M.P. § 528, the Declaration of Prof. Lisa Davidson, Ph.D., dated March 19, 2015 (the “Davidson Decl.”), and the Declaration of Michael Kuderka, dated March 30, 2015 (the “Kuderka Decl.”), Forest Laboratories, LLC (“Forest, LLC” or “Opposer”), respectfully moves the Trademark Trial and Appeal Board (the “Board”) to (a) enter summary judgment finding likelihood of confusion and denying registration of Sebela International Ltd.’s (“Applicant”) SEBELA mark, U.S. App. Serial No. 86/127,398 (“SEBELA Application”); or (b) alternatively, to grant Opposer partial summary judgment (1) on the issues of standing, priority, and any of the du Pont factors about which the Board determines there is no genuine dispute of material fact and (2) to strike Applicant’s Sixth Affirmative Defense. Opposer has timely filed this motion prior to the opening of the first testimony period.

PRELIMINARY STATEMENT

The Board should deny registration of the SEBELA Application because its use in commerce poses a potential danger to the public health. Opposer’s SAVELLA mark (used to

treat fibromyalgia and neuropathic pain disorders) is virtually identical to Applicant's SEBELA mark (used to treat dermatological and gastroenterological conditions) and both are used for prescription pharmaceuticals. If cross-prescription confusion were to occur, a consumer intending to receive treatment for gastroenterological or skin conditions would receive treatment for fibromyalgia, or *visa versa*, which clearly pose potential health concerns. The Board should deny the SEBELA Application for this reason alone.

Moreover, when prescription pharmaceuticals are at issue, numerous cases mandate that the Board apply the doctrine of "Extra Care," which requires the Board to deny registration in the event there even is a slight possibility of consumer confusion, rather than the traditional likelihood of consumer confusion standard the Board ordinarily applies. Here, the respective marks SEBELA and SAVELLA are so close in appearance, sound, connotation and commercial impression that summary judgment would be appropriate even without the enhanced standard applicable to pharmaceuticals. When the "slight possibility of consumer confusion" standard is applied, however, the case for summary judgment is even more indisputable.

UNDISPUTED FACTS AND PROCEDURAL HISTORY

Opposer's SAVELLA Marks:

Forest, LLC owns two federal registrations for SAVELLA:

1. SAVELLA, for "pharmaceutical preparations for the treatment of fibromyalgia and neuropathic pain disorders" in Class 5 (Reg. No. 3,658,661), which Forest Laboratories, Inc.¹ ("Forest, Inc.") filed on June 21, 2007, and which matured into a registration on July 21, 2009. Ex. A. The mark has been in continuous and actual use in the United States since

¹ Ownership of SAVELLA (Reg. No. 3,658,661) changed from Forest, Inc. to Opposer pursuant to a merger and change of name executed February 17, 2014. See Ex. A at 2-3. Opposer recorded the change in ownership on September 16, 2014. Id.

² Ownership of SAVELLA and Design (Reg. No. 3,761,078) changed from Forest, Inc. to Opposer

April 24, 2009. See Id. at 1.

2. SAVELLA and Design for “printed matter, namely, brochures, pamphlets, posters, newsletters, promotional materials, patient educational materials, all concerning the treatment of fibromyalgia and neuropathic pain disorders” in Class 16, and “medical informational services, namely, providing health information in the field of fibromyalgia and neuropathic pain disorders via a global computer network” in Class 44 (Reg. No. 3,761,078), which Forest, Inc.² filed on August 3, 2009, and matured into a registration on March 16, 2010. Ex. B. The mark has been in continuous and actual use in Class 16 since May 17, 2009, and in Class 44 since January 15, 2009. See Id. at 1.

The marks SAVELLA and SAVELLA and Design are sometimes collectively referred to as the “SAVELLA Marks.”

Applicant’s SEBELA Mark

On November 22, 2013, Applicant filed a federal intent-to-use application for SEBELA, for “[m]edicated and pharmaceutical preparations, both prescription and over-the-counter, for use in dermatology; and, medicated and pharmaceutical preparations, both prescription and over-the-counter, for use in gastroenterology” in Class 5 (Serial No. 86/127,398) (the “SEBELA Application”). Ex. C. That application was published for opposition on April 22, 2014. Id., at 2.

ARGUMENT

Legal Standard

A party may move for summary judgment on all or part of a claim or defense. See Fed.

R. Civ. P. 56 (a). Summary judgment is appropriate where “the movant shows that there is no

² Ownership of SAVELLA and Design (Reg. No. 3,761,078) changed from Forest, Inc. to Opposer pursuant to a merger and change of name executed February 17, 2014. See Ex. B at 2-3. Opposer recorded the change in ownership on September 16, 2014. Id.

genuine dispute as to any material fact and the movant is entitled to judgment as a matter of law.” Id.; see also Sweats Fashions, Inc. v. Pannill Knitting Co. Inc., 833 F.2d 1560, 1562, 4 U.S.P.Q.2d (BNA) 1793, 1795 (Fed. Cir. 1987); Flow Tech, Inc. v. Picciano, 18 U.S.P.Q.2d (BNA) 1970, 1971 (T.T.A.B. 1991); TBMP § 528.01. To determine whether there is a likelihood of confusion, the Board considers the factors set forth in E. I. du Pont De Nemours & Co., 476 F.2d 1357, 1361 (C.C.P.A. 1973). See Palm Bay Imps. v. Veuve Clicquot Ponsardin Maison Fondee En 1772, 396 F.3d 1369, 1371, 73 U.S.P.Q.2d (BNA) 1689 (Fed. Cir. 2005); see also E.&J. Gallo Winery v. Malek, No. 91,199,089, 2012 TTAB LEXIS 368, *7 (T.T.A.B. Sept. 14, 2012).

The Board Encourages the Resolution of Board Proceedings By Summary Judgment

The Board encourages resolution of opposition proceedings by summary judgment. See Smithkline Beecham PLC v. TopoTarget ApS Corp, Opp. No. 91,157,491, 2004 TTAB LEXIS 504, at *4-5 (T.T.A.B. 2004) (citing Sweats Fashions, Inc., 833 F.2d at 1562, 4 U.S.P.Q.2d (BNA) at 1795). The purpose of summary judgment, as has often been stated, is judicial economy, namely, to save the time and expense of a useless trial where no genuine conflict of material fact remains and more evidence than is already available in connection with the motion for summary judgment could not be reasonably expected to change the result. See, e.g., Levi Strauss & Co. v. Genesco, Inc., 742 F.2d 1401, 1403, 222 U.S.P.Q. (BNA) 939 (Fed. Cir. 1984); Pure Gold, Inc. v. Syntex (U.S.A.), Inc., 739 F.2d 624, 626, 222 U.S.P.Q. (BNA) 741 (Fed. Cir. 1984).

Standing and Priority of Use

There is no genuine conflict of material fact as to Opposer’s standing or priority of use. Current printouts of information from the USPTO electronic database records, specifically the

USPTO's Trademark Status and Document Retrieval system, showing the status and title of Nos. 3,658,661 and No. 3,761,078 are submitted with this motion at Exs. A and B. See Kmart of Mich, Inc. v. Millyon Mktg. Concepts, Opp. No. 91,124,776, 2005 TTAB LEXIS 398, at *9 (T.T.A.B. Sept. 16, 2005) (citing King Candy Co. v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 1401, 182 U.S.P.Q. (BNA) 108 (C.C.P.A. 1974). See also J. C. Hall Co. v. Hallmark Cards, Inc., 52 C.C.P.A. 981, 984, 144 U.S.P.Q. (BNA) 435 (C.C.P.A. 1965) ("A certificate of registration constitutes *prima facie* evidence of ownership and ownership imparts *prima facie* evidence of use even though there be no evidence of record relative to such use. The presumption of use emanating from the fact of registration relates back to the filing date of the application on which the registration is predicated"); see also TBMP § 528.05(d).

I. BECAUSE PRESCRIPTION PHARMACEUTICALS ARE AT ISSUE, THE DOCTRINE OF "EXTRA CARE" APPLIES AND LAW AND PUBLIC POLICY REQUIRE THAT EVEN A SLIGHT POSSIBILITY OF CONFUSION BE AVOIDED

When pharmaceuticals are at issue, the law provides that "it is imperative that even a slight possibility of confusion be avoided." In re Merck & Co., Inc., 189 U.S.P.Q. (BNA) 355, 355 (T.T.A.B. 1975) (citing Morgenstern Chemical Company, Inc. v. G. D. Searle & Company, 253 F.2d 390, 394, 116 U.S.P.Q. (BNA) 480 (3d Cir. 1958) (holding that, "[i]n the field of medicinal remedies the courts may not speculate as to whether there is a probability of confusion between similar names. If there is **any possibility** of such confusion in the case of medicines, public policy requires that the use of the confusingly similar name be enjoined.") (emphasis added)); see also Alfacell Corp. v. Anticancer, Inc., 71 U.S.P.Q.2d (BNA) 1301, 1306 (T.T.A.B. 2004) (citing Glenwood Laboratories, Inc. v. American Home Products Corp., 59 C.C.P.A. 948, 951-53, 455 F.2d 1384, 1386-87, 173 U.S.P.Q. (BNA) 19, (C.C.P.A. 1972)); A. H. Robins Co. v. Striegel, Opp. No. 91,101,325, 2000 TTAB LEXIS 84, *13 (T.T.A.B. Mar. 1, 2000) (holding

that “[i]n a case involving pharmaceutical products, where the consequences of confusion can have disastrous results, there is an even stronger reason for resolving doubt in this manner”); Blansett Pharmacal Co. Inc. v. Carmrick Laboratories Inc., 25 U.S.P.Q.2d (BNA) 1473, 1477 (T.T.A.B. 1992); Schering Corp. v. Alza Corp., 207 U.S.P.Q. (BNA) 504, 509 (T.T.A.B. 1980); and American Home Products Corp. v. USV Pharmaceutical Corp., 190 U.S.P.Q. (BNA) 357, 360 (T.T.A.B. 1976); see also Kos Pharms., Inc. v. Andrx Corp., 369 F.3d 700, 730-732, 70 U.S.P.Q.2d (BNA) 1874 (3d Cir. 2004).

As stated by the court in Schering Corp., 207 U.S.P.Q. (BNA) at 509, when dealing with pharmaceutical products, “it is well established that in such a field great care must be taken to prevent any possibility of confusion in the use of trademarks.” The Schering court cited longstanding law set forth in Morgenstern Chemical Company, Inc., 253 F.2d at 393-94, where the court stated:

In the field of medicinal remedies the Courts may not speculate as to whether there is probability of confusion between similar names. If there is any possibility of such confusion in the case of medicines, public policy requires that the use of the confusingly similar name be enjoined.

Id. at 393. This view, that a higher standard applies to medicinal products so that no harmful confusion occurs, is also supported by the following cases: Clifton v. Plough, 52 C.C.P.A. 1045, 1047, 341 F.2d 934, 144 U.S.P.Q. (BNA) 599 (C.C.P.A. 1965); Campbell Products Inc. v. John Wyeth & Bro., Inc., 31 C.C.P.A. 1217, 1220, 143 F.2d 977, 62 U.S.P.Q. (BNA) 302, 304 (C.C.P.A. 1944); and Glenwood Laboratories, Inc., 59 C.C.P.A. at 951-53.

When pharmaceuticals are at issue, tribunals are careful to protect public health. See E.R. Squibb & Sons, Inc. v. Kos Pharms., Inc., Opp. No. 101,510, 2000 TTAB LEXIS 216, at *12-17 (T.T.A.B. April 14, 2000) (See attached at Ex. D). In E.R. Squibb, the T.T.A.B. found that:

The trademark doctrine of ‘Extra Care’ or ‘Greater Care’ for pharmaceuticals stands for the proposition that when the consequences of confusion are much more serious, relief should be granted to the senior user upon a lesser proof of confusing similarity in a prescription drug case than in other areas of trademark litigation. Both logic and sound policy support this result.

Id. at *13. The Board emphasized that even when there is no evidence of an adverse reaction to misprescription, there is an opportunity cost associated with not receiving the proper medication in the first instance:

The result of confusion could be physical injury to members of the consuming public, whether through adverse reaction to inadvertently prescribed or dispensed drugs, or through simple failure to receive effective medications. For even if it has not been established in the record herein that harmful effects could result from confusion, there is likely an opportunity cost. If, for example, the ‘MYCOSTATIN’ product had been prescribed but a patient received the ‘NICOSTATIN’ preparation for treatment of hyperlipidemia, the patient would not obtain relief of the symptoms attributed to the fungal infection, and the person might be one for whom the ‘NICOSTATIN’ product is contraindicated. Similarly, a person seeking relief from an excess of lipids in the blood would obtain no relief if the ‘MYCOSTATIN’ product rather than the ‘NICOSTATIN’ product is inadvertently taken or administered.

Id. See also Morgenstern Chemical Company, Inc., 253 F.2d at 393-94 (finding MICTINE confusingly similar to MICTURIN, where the marks were used with medicinal tablets taken orally for different ailments.); Glenwood Laboratories, Inc., 59 C.C.P.A. at 951-53 (finding MYOCHOLINE so resembles MYSOLINE that confusion is likely); Blansett Pharmacal Co. Inc., 25 U.S.P.Q.2d (BNA) at 1477 (finding confusion likely between NALEX and NOLEX for pharmaceuticals); In re Star Pharmaceuticals, Inc., 221 U.S.P.Q. (BNA) 84, 85-86 (T.T.A.B. 1984) (finding STAR and design likely to be confused with STARR and design); American Home Products Corporation, 190 U.S.P.Q. (BNA) at 360 (finding PRESAMINE so resembles PREMARIN that confusion is likely); In re Merck & Co., Inc., 189 U.S.P.Q. (BNA) at 355 (finding M-M-VAX so similar to M-VAC that confusion is likely); Breon Laboratories Inc. v. Vargas, 170 U.S.P.Q. (BNA) 532, 536 (T.T.A.B. 1971) (finding confusion likely between

BRONCO-FEDRIN and BRONKEPHRINE).

Since there is much more than “a slight possibility of confusion” between SEBELA and SAVELLA, as set forth in greater detail below, the Board must refuse registration of the SEBELA application.

II. THE BOARD SHOULD REFUSE REGISTRATION OF SEBELA BECAUSE THERE IS FAR MORE THAN A SLIGHT POSSIBILITY OF CONFUSION BETWEEN SAVELLA AND SEBELA, WHICH ARE BOTH FOR PRESCRIPTION PHARMACEUTICALS

To determine whether there is any possibility of consumer confusion, the Board compares the marks for similarity in appearance, sound, connotation and commercial impression; the Board compares the goods or services to determine if they are related or if the activities surrounding their marketing are such that confusion as to origin is likely; the Board compares trade channels for the goods; and the Board may also examine other factors, such as purchaser sophistication. See Nat’l Paintball Supply, Inc. v. Quebec, Inc., Opp. No. 115,862, 2002 TTAB LEXIS 35, at *8 (T.T.A.B. Feb. 27, 2002) (citing In re E. I. du Pont de Nemours & Co., 476 F.2d at 1361).

A. The Parties’ Marks Are Virtually Identical

Similarity of the respective marks in appearance, sound, connotation and commercial impression is the first factor that the Board must consider. See Johnson & Johnson v. Kumar, Opp. No. 91,152,039, 2009 TTAB LEXIS 663 at *25-26 (T.T.A.B. Nov. 2, 2009) (citing In re E. I. du Pont de Nemours & Co., 476 F.2d at 1361). As stated by the Johnson court:

The test, under the first du Pont factor, is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks.

Id. at *25 (citing Sealed Air Corp. v. Scott Paper Co., 190 U.S.P.Q. (BNA) 106 (T.T.A.B.

1975)).

The facts in Johnson & Johnson were similar to the present case. There, the Board compared the marks DURAGESIC for “analgesic preparations administered transdermally in the form of a bandage or patch” and DERMOGESIC for “transdermal patches for use in the treatment of post-surgical pain and pre-surgical analgesic.” It stated:

Comparing the marks in terms of appearance, we find that they are similar in that both marks begin with the letter “d” and end in “gesic.” We find that these points of similarity outweigh the difference in appearance which results from the different letters in the middle of the respective marks. In terms of sound, we find that the marks are highly similar. Both marks begin with the identical-sounding syllable “dur” or “der,” and end with the identical sounding “gesic.” The second syllable in each mark sounds different, but that syllable is unstressed in each mark. We find that the marks considered in their entirety are similar in terms of sound.

Johnson & Johnson, 2009 TTAB LEXIS 663 at *26 (citing Alfacell, 71 U.S.P.Q.2d (BNA) at 1305 (finding ONCASE similar to ONCOCASE)).

Here, there are only two minor differences between the marks: first, the inclusion of “E” and “B” in SEBELA instead of the “A” and “V” in SAVELLA and, second, the additional “L” in SAVELLA. The resulting difference in sight is very slight.

The marks SEBELA and SAVELLA have virtually no difference in sound. According to Dr. Lisa Davidson, a well-regarded linguistics professor at New York University, American English speakers will pronounce the words SAVELLA and SEBELA virtually identically. See Declaration of Lisa Davidson, dated March 19, 2015 (“Davidson Decl.”), at ¶¶ 1-7.³ The only difference in sound would be between the “B” and the “V.” See Id. at ¶ 4. These are, however,

³ Dr. Davidson states that American English speakers might pronounce the marks differently if they were spoken in the same sentence for the purpose of comparison. See Davidson Decl., ¶ 7. However, the Board here is not concerned with the impression marks make when being actively compared. The issue is whether there is a likelihood of confusion (here any possibility of confusion) if consumers who hear the mark SAVELLA believe that they are hearing SEBELA, or vice versa.

“among the more confusable pairs of English sounds even when they are precisely produced.”

Id. ¶ 5. Under almost any normal circumstance, American consumers would not precisely produce those sounds, but instead would pronounce both marks as /səβɛlə/. See Id. at ¶ 7. This also means that American consumers who hear the spoken words, SAVELLA and SEBELA, will also hear them as being identical words.

The Board and courts have repeatedly found a likelihood of confusion when there are only minor differences in pronunciation. See Kroeger Herb Prods. Co. v. Shaperite Concepts, Ltd., Opp. No. 28,369, 2001 TTAB LEXIS 654, *4 (T.T.A.B. 2001) (“When spoken, any minor differences in sound between LINE and LEAN [in the marks METALINE and META-LEAN] may go undetected since they are quite similar in terms of their pronunciation”). The potential confusion of the present marks is increased because they are both coined terms, without any correct pronunciation. As stated by the Board in E.R. Squibb & Sons, Inc., “[o]f course, under trademark law, there is no ‘correct’ pronunciation of a coined mark like ‘nicostatin.’” 2000 TTAB LEXIS 216, at *9 (citing Barton Mfg. Co. v. Hercules Powder Co., 24 C.C.P.A. 982, 985-85, 88 F.2d 708, 710, 33 U.S.P.Q. (BNA) 105, 107 (C.C.P.A. 1937) (“DYANSHINE” and “DISHINE”); see also The Mennen Company v. Yamanouchi Pharmaceutical Co., Ltd., 203 U.S.P.Q. (BNA) 302 (T.T.A.B. 1979) (“MINON” resembles “MENNEN”); Eli Lilly And Company v. Burlington Pharmacal, Inc., 161 U.S.P.Q. (BNA) 370, 373 (T.T.A.B. 1969) (“AMOSSED” resembles “AMESEC”)).

The marks in question could easily be pronounced identically.⁴ See Davidson Decl., ¶ 7.

⁴ Applicant may contend the marks will be pronounced differently, but it is well established that a mark owner cannot control how its mark will be pronounced when spoken. See, e.g., Pfizer Inc. v. Soft Gel Techs., Inc., Opp. No. 91,117,607, 2003 TTAB LEXIS 27, *11-12 (T.T.A.B. Jan. 29, 2003); Yamaha International Corp. v. Stevenson, 196 U.S.P.Q. (BNA) 701, 703 (T.T.A.B. 1977). See also DuPont v. Sunlyra Int’l Co., 35 U.S.P.Q.2d (BNA) 1787, 1789 (T.T.A.B. 1995).

Similarity in sound alone may be sufficient to support a finding of likelihood of confusion. See, e.g., RE/MAX of America, Inc. v. Realty Mart, Inc., 207 U.S.P.Q. (BNA) 960, 964 (T.T.A.B. 1980) (finding likelihood of confusion between RE/MAX and REMACS based on similarity of sound); Molenaar, Inc. v. Happy Toys Inc., Opp. No. 54,350, 1975 TTAB LEXIS 1, *5 (T.T.A.B. May 30, 1975) (finding similarity of FINGER-MAGIC and FINGA-MAGICS based on similarity of sound alone) (see Ex. E); In re Cresco Mfg. Co., 138 U.S.P.Q. (BNA) 401, 402 (T.T.A.B. 1963) (finding likelihood of confusion between CRESCO and KRESSCO based on sound alone); TMEP § 1207.01(b)(iv). In In re Aesgen, Inc., Ser. No. 76/500,182, 2006 TTAB LEXIS 286 (T.T.A.B. July 25, 2006), the Board's analysis of marks' similarities is highly instructive and relevant here. The Board stated:

Applicant's mark is PROTORIS and Registrant's mark is PROTEROS. The prefix PRO could have the same pronunciation in both marks. The "TOR" portion of PROTORIS and the "TER" portion of PROTEROS could have the same pronunciation given that "TOR" can be pronounced as it is in DOCTOR. The "RIS" portion of PROTORIS and the "ROS" pronunciation of PROTEROS could have the same pronunciation given that "ROS" can be pronounced as it is in RHINOCEROS. The marks may not only have similar pronunciations, they are visually similar. PROTORIS and PROTEROS have the same consonants in the same order and are separated by single vowels. In addition, both Applicant and Registrant's marks are in typed form. Thus, there are no design elements to aid in distinguishing the marks.

Id. at *5-6.

When considered in their entirety, the present marks are very similar in appearance. When the words are written in the upper case, the changed letters result in little visual difference and, when written in the lower case (i.e. "sebela" and "savella"), both have two characters with lines that ascend above the height of the other letters ("b" and "l" in "sebela" and "l" and "l" in "savella"), resulting in little significant visual effect. Cf. Pfizer Inc., 2003 TTAB LEXIS 27, *11-12 (finding GLUCOTROL and GLUCOSOL "very similar in sight and sound"); Pharmacia & Upjohn Co. v. Generation Health, 44 U.S.P.Q.2d (BNA) 1091, 1094 (W.D. Mich. 1997)

(finding that it “cannot seriously be questioned that the marks [COLESTID and CHOLESTIN] are similar in appearance and spelling” and their “phonetic similarity exceeds their visual similarity”).

Thus, there is no genuine dispute of material fact that the marks are not only similar but virtually identical in appearance, pronunciation, meaning and commercial impression. Cf. Pennwalt Corporation v. Center Laboratories, Inc., 524 F.2d 235, 187 U.S.P.Q. (BNA) 599, 601 (C.C.P.A. 1975) (finding marks ALLEREST and ALLERSET “very similar when considered in their entirety, in appearance, sound and commercial impression”).

This factor strongly favors Opposer.

B. The Parties’ Goods Are Both Prescription Pharmaceuticals

The next factor is the similarity of the nature of the goods. See In re E. I. du Pont de Nemours & Co., 476 F.2d at 1361. More similar marks require less similarity between goods to support a finding of likelihood of consumer confusion. See L’Oreal S.A. v. Marcon, 102 U.S.P.Q.2d (BNA) 1434, 1438-1439 (T.T.A.B. 2012); In re Concordia Int’l Forwarding Corp., 222 U.S.P.Q. (BNA) 355, 356 (T.T.A.B. 1983) (“If the marks are the same or almost so, it is only necessary that there be a **viable relationship between the goods** or services in order to support a holding of likelihood of confusion.”) (emphasis added); In re Phoenix Intangibles Holding Co., Ser. No. 76/470,576, 2004 TTAB LEXIS 677, *9-10 (T.T.A.B. Nov. 12, 2004) (holding that, when marks are essentially identical, like BRILLIANCE for floor cleaning preparations and applicant’s mark BRILLIANCEGUARD for dishwashing detergent, “it is only necessary that there be a viable relationship between the goods in order to support a holding of likelihood of confusion”).

1. The Parties Goods are Legally Related Because One Could Reasonably Expect them to Emanate From the Same Source

i. The Goods Are Determined Based on what is Recited in the Marks Respective Applications or Registrations

The nature and scope of a party's goods or services must be determined on the basis of the goods or services recited in the application or registration. See Hewlett-Packard Co. v. Packard Press Inc., 281 F.3d 1261, 62 U.S.P.Q.2d 1001, 1004 (Fed. Cir. 2002); Cunningham v. Laser Golf Corp., 222 F.3d 943, 55 U.S.P.Q.2d 1842, 1848 (Fed. Cir. 2000). In Novartis Int'l Pharm., Ltd. V. Genetic Immunity, LLC, the Board stated:

Turning to the goods, opposer's registrations for DENAVIR include goods identified simply as "pharmaceutical preparations, namely antivirals." These registrations do not limit opposer's goods to antivirals used for any particular purposes. Similarly, applicant's application is not limited to vaccines for the prevention of any particular ailment; the identification is simply for "vaccines and vaccine adjuvants." Thus, any distinctions between the actual uses to which opposer puts its antiviral preparations and applicant puts its vaccines is of no moment. It is well established that the question of likelihood of confusion must be determined based on an analysis of the mark as applied to the goods and/or services recited in applicant's application vis-a-vis the goods and/or services recited in an opposer's registration, rather than what the evidence shows the goods and/or services to be.

Opp. No. 91,124,457, 2004 TTAB LEXIS 79, *17-18 (T.T.A.B. Feb. 24, 2004) (citing Canadian Imperial Bank of Commerce v. Wells Fargo Bank, N.A., 811 F.2d 1490, 1 U.S.P.Q.2d 1813 (Fed. Cir. 1987)).

Here, Opposer's SAVELLA mark is for "pharmaceutical preparations for the treatment of fibromyalgia and neuropathic pain disorders." Ex. A at 1. Applicant's SEBELA mark is for "Medicated and pharmaceutical preparations, both prescription and over-the-counter, for use in dermatology; and, medicated and pharmaceutical preparations, both prescription and over-the-counter, for use in gastroenterology." Ex. C at 1.

**ii. Even if the Marks are Deemed Not to be Directly Competitive,
Confusion Remains Likely**

The Board may find a likelihood of confusion between similar marks, even where the goods do not directly compete. E.R. Squibb & Sons, 2000 TTAB LEXIS 216, at *11. “[T]he law has long protected the legitimate interests of trademark owners and consumers from confusion among noncompetitive, but related, products bearing confusingly similar marks.” Safety-Kleen Corp. v. Dresser, Inc., 518 F.2d 1399, 1404, 186 U.S.P.Q. (BNA) 476 (C.C.P.A. 1975). The underlying goods and services may be different, but nevertheless sufficiently related, that purchasers would reasonably expect them to emanate from the same source, or believe them to be affiliated with or sponsored by the trademark owner. See In re Majestic Distilling Co., 315 F.3d 1311, 1314-15, 65 U.S.P.Q.2d (BNA) 1201 (Fed. Cir. 2003); see also In re Melville Corp., 18 U.S.P.Q.2d (BNA) 1386, 1388 (T.T.A.B. 1991).

The Board’s analysis in E.R. Squibb & Sons is instructive here, where it found non-competitive products for different indications to be confusingly similar. It stated:

Opposer’s MYCOSTATIN is a preparation sold for the treatment of cutaneous or mucocutaneous fungal infections caused by *Candida albicans* and other species of *Candida*, including diaper rash. Applicant’s NICOSTATIN is intended for the treatment of hyperlipidemia, or an excess of fat or lipids in the blood. Hence, both are prescription medications having quite different indications. These two medicaments would clearly not be competitive, but that alone is not determinative as to the relatedness of the goods. Both would be available in oral forms, and the testimony herein confirms that there could be an overlap in their usage since an adult with a *Candida* fungal infections as well as hyperlipidemia may well end up having both medications prescribed simultaneously. Hence, we find that this critical du Pont factor also favors opposer herein.

E.R. Squibb, 2000 TTAB LEXIS 216, at *11.

Applicant’s SEBELA Class 5 application for “[m]edicated and pharmaceutical preparations, both prescription and over-the-counter, for use in dermatology; and, medicated and pharmaceutical preparations, both prescription and over-the-counter, for use in gastroenterology”

and Opposer's Class 5 registration for SAVELLA for "pharmaceutical preparations for the treatment of fibromyalgia and neuropathic pain disorders" are related goods because they may both be obtained through prescription and both are used for the alleviation of pain. In re Merck & Co., Opp. No. 63,456, 1982 TTAB LEXIS 35, at *3-4 (T.T.A.B. 1992) (see Ex. F); Kroeger Herb Prods. Co., 2001 TTAB LEXIS 654, at *4 (dietary supplements deemed to be "closely related goods" even though one was sold as a weight loss product and the other as cleansing formula designed for those concerned about metal poisoning.); Novartis International Pharmaceutical, Ltd., 2004 TTAB LEXIS 79, at *1, 22-23 (DERMAVIR for "vaccines and vaccine adjuvants" found confusingly similar to DENAVIR for antiviral medications).

The respective goods would be sufficiently related even if it were not for the heightened standards that apply herein. However, when the Board considers that "it is imperative that even a slight possibility of confusion be avoided" (In re Merck & Co., Inc., 189 U.S.P.Q. (BNA) at 355), and that the goods need not be as related given the close similarity of the respective marks, this factor very strongly favors Opposer. This second factor, along with the similarity of the respective marks, is dispositive of this motion.

C. The Channels of Trade are Identical.

The next factor to consider is the dissimilarity or similarity of likely-to-continue trade channels. See In re E. I. du Pont de Nemours & Co., 476 F.2d at 1361. Because Applicant's channels of trade are unrestricted in its application, it is presumed that applicant's goods move in all channels of trade and reach all classes of purchasers. See San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp., 565 F.2d 683, 685, 196 U.S.P.Q. (BNA) 1 (C.C.P.A. 1977); Nat'l Paintball Supply, Inc., 2002 TTAB LEXIS 35, at *9.

Here, both Applicant's and Opposer's goods are pharmaceuticals and are presumed to be prescription and sold in pharmacies because there are no limitations on the goods in the description. This factor also strongly favors Opposer.

D. The Sophistication of Pharmacists Does not Outweigh the Danger of Confusion Should it Occur

The next factor to consider is whether the purchase is made on impulse or after the careful consideration of a sophisticated party. See In re E. I. du Pont de Nemours & Co., 476 F.2d at 1361. While a physician writing a prescription and a pharmacist filling it may each be relatively sophisticated, the Board has noted that two prescription products might well be placed side-by-side in the patient's medicine cabinet, vulnerable to accidental substitution, after they are purchased. See E.R. Squibb, 2000 TTAB LEXIS 216, at *15 (holding "it should also be noted that these two prescription products might well be placed side-by-side in the patient's medicine cabinet, subject to the accidental substitution of one product for the other"). Moreover, it is well established that, "[w]here the purchasers of the goods include both professionals and non-professionals, as it does here, the standard of care in purchasing is that which would be exercised by the least sophisticated purchaser." Johnson & Johnson v. Kumar, Opp. No. 91,152,039, 2009 TTAB LEXIS 663, *34 (T.T.A.B. Nov. 2, 2009) (citing Alfacell, 71 U.S.P.Q.2d at 1306); see also KOS Pharmaceuticals Inc., 369 F.3d at 716 (citing Checkpoint Sys., Inc. v. Check Point Software Techs., Inc., 269 F.3d 270, 285, 60 U.S.P.Q.2d (BNA) 1609 (3d Cir. 2001) ("where both professionals and the general public are relevant consumers, the standard of care to be exercised . . . will be equal to that of the least sophisticated consumer in the class"). Patients from the general public will not exercise the degree of care exhibited by medical professionals. As also stated by the Third Circuit in KOS Pharmaceuticals Inc.:

While doctors and pharmacists play a gate-keeping role between patients and prescription drugs, they are not the ultimate consumers. Patients are. Courts have

noted that drugs are increasingly marketed directly to potential patients through, for example, ask-your-doctor-about-Brand-X style advertising.

KOS Pharmaceuticals Inc., 369 F.3d. at 716 [citations omitted].

There is also a very serious concern of confusion among pharmacists. If a prescription is made over the phone, the similar sounding names could be confused. See Novartis Int'l Pharm., Ltd., 2004 TTAB LEXIS 79, *21-22 (holding “there is a concern that a pharmacist, getting a prescription over the phone, would have trouble distinguishing between the marks DENAVIR and DERMAVIR, or may have trouble deciphering the marks in a handwritten prescription”). Thus, this du Pont factor favors opposer. See Novartis Int'l, 2004 TTAB 79, at *21-22. As stated by the Board in E.R. Squibb:

We should point out that specialized physicians and competent pharmacists are not infallible. The observations made years ago by Assistant Commissioner for Trademarks, Daphne Leeds, are also quite appropriate to recall at this juncture: “. . . physicians are not immune from confusion or mistake. Furthermore, it is common knowledge that many prescriptions are telephoned to the pharmacist and others are handwritten, and frequently the handwriting is not unmistakably legible. These facts enhance the chances of confusion or mistake by the pharmacist in filling the prescription if the marks appear too much alike when handwritten or sound too much alike when pronounced.

E.R. Squibb, 2000 TTAB LEXIS 216, at *14-15 (quoting R. J. Strassenburgh Company v. Kenwood Laboratories, Inc., 106 U.S.P.Q. (BNA) 379, 380 (Com'r Pat 1955); see also In re Merck & Co., Inc. 189 U.S.P.Q. (BNA) at 355 (finding that “the marks are believed to be so close in sound, appearance and meaning that even physicians and pharmacists, who are expected to exercise a higher degree of care, would not be immune from mistake”).

The Board considered a set of facts comparable to the instant opposition in Johnson & Johnson v. Kumar, Opp. No. 91,152,039, 2009 TTAB LEXIS 663, *26-34 (T.T.A.B. Nov. 2, 2009). There, the Board recognized that, although the parties' respective pharmaceuticals would be prescribed by physicians and dispensed by pharmacists, and that those professionals are

relatively likely to be sophisticated and careful, this does not in any way preclude consumer confusion. The Board stated:

[P]rofessionals' medical expertise with respect to pharmaceuticals does not necessarily ensure that they would not be confused when encountering applicants' and opposer's legally identical goods sold under confusingly similar marks. Nor does it ensure that mistakes would not be made during the process of the physician's prescription of the drugs and the pharmacist's dispensing of the drugs to patients at the retail pharmacy counter.

Id. at *32-33. Thus, even if the Board were to consider sophisticated professionals when weighing this du Pont factor, because the marks are similar and the goods are legally identical, this fourth factor heavily favors Opposer. Therefore, there can be no genuine controversy that this du Pont factor strongly favors Opposer's position that the marks are confusingly similar.

E. SAVELLA is Well-Known in the Relevant Trade

The next factor to consider is the fame of the prior mark, namely in sales, advertising, and length of use. See In re E. I. du Pont de Nemours & Co., 476 F.2d at 1361. According to the declaration of Michael Kuderka, during 2014, sales of the pharmaceutical Savella in the United States were \$133 million. See Kuderka Decl., ¶ 2. During that same time, Opposer has expended more than \$2 million in advertising the SAVELLA mark in the United States. See Id., ¶ 3. Moreover, Opposer has used the mark SAVELLA in commerce in the United States since April 24, 2009. See Ex. A at 1. Opposer's mark SAVELLA and Design has been in continuous and actual use in Class 16 since May 17, 2009, and in Class 44 since January 15, 2009. See Ex. Ex. B. at 1. The amount earned in sales and spent on advertising as well as the duration of Opposer's use of the SAVELLA Marks in commerce strongly favor Opposer on this du Pont factor.

F. There is No Evidence of Third-Party Use of Marks Similar to SAVELLA on Goods or Services Similar to the SAVELLA Marks

The next du Pont factor to consider is evidence of third-party use of similar marks on

similar goods, which “is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection.” See Palm Bay Imps., 396 F.3d at 1373. Here, there are no other registrations or pending applications containing “SAVELLA.” The only pending application which is similar to the SAVELLA marks, in terms of the mark’s sight, sound and identification of goods, is the SEBELA application.⁵ This means that the Opposer’s SAVELLA Marks are strong and the Board should find that the sixth du Pont factor favors Opposer.

G. Actual Confusion Is Not Necessary

Because there is little, if any, information on the extent of applicant’s use of SEBELA, the seventh and eighth du Pont factors are neutral.⁶ See Novartis Int’l, 2004 TTAB 79, at *22. Opposer is not required to prove actual confusion in order to make a *prima facie* showing of likelihood of confusion. See Sentry Chem. Co. v. Cent. Mfg. Co., Opp. No. 91,108,924, 2000 TTAB LEXIS 155, at *7-8 (T.T.A.B. Mar. 8, 2000); see also Block Drug. Co. v. Den-Mat, Inc., 17 U.S.P.Q.2d (BNA) 1315, 1318 (T.T.A.B. 1989) (“it is not necessary that actual confusion be proved. The test here is likelihood of confusion and that is all that is necessary to prevail under Section 2(d)”); see also Guardian Prods. Co. v. Scott Paper Co., 200 U.S.P.Q. (BNA) 738, 741 (T.T.A.B. 1978); see also In re Calgon Corp., 58 C.C.P.A. 830, 832, 168 U.S.P.Q. (BNA) 278 (C.C.P.A. 1971) (“Lack of evidence of actual confusion or mistake, of course, does not preclude a finding of likelihood of confusion”).

This factor is neutral.

⁵ The owner of SAVELIENS recently amended the identification of goods, pursuant to an agreement, to delete the following Class 5 identification of goods “[p]harmaceutical products, namely, nutritional supplements, dietetic foods, namely, nutritional food bars and meal replacement shakes for weight loss purposes; dietary supplements for medical purposes; medical preparations for slimming purposes; appetite suppressants for medical purposes; and dietary fiber.” Ex. G.

⁶ The 7th du Pont factor is the nature and extent of actual confusion. The 8th du Pont factor is the extent to which Applicant’s mark and Opposer’s mark have co-existed without actual confusion.

H. Opposer uses the SAVELLA Marks on a Variety of Goods and Services

The next duPont factor, the variety of goods on which a mark is or is not used, also favors Opposer. See In re E. I. du Pont de Nemours & Co., at 1361. Opposer's use of a mark on a variety of goods increases the chances of consumer confusion. See Orlando Food Corporation v. Orlando Baking Co., 2000 TTAB LEXIS 248, *9-10 (T.T.A.B. 2000). In the Orlando Food case, the opposer registered the mark ORLANDO for a variety of food products (all or most of which can be used as toppings for pizza), including canned fish, cheese, vegetables such as artichoke hearts, olives, and roasted peppers, as well as canned vegetables, and tomato sauce and tomato paste. Id. The Board found that purchasers aware of the variety of opposer's goods sold under the mark ORLANDO may well assume that opposer is now offering pizza and other bakery products sold under Applicant's mark ORLANDO. See Id.; see also Uncle Ben's, Inc. v. Stubenberg Int'l, Inc., 47 U.S.P.Q.2d (BNA) 1310, 1313 (T.T.A.B. May 27, 1998) (finding that "the fact that opposer applies its mark to a variety of products including rice mixes and stuffing mixes consisting primarily of bread is significant . . . this makes it more likely that purchasers, aware of opposer's use of UNCLE BEN'S on a variety of food products, when seeing applicant's mark used in connection with a bread mix, are likely to believe that this product is also being produced or sponsored by opposer").

Opposer uses SAVELLA with a variety of goods and services, namely: "pharmaceutical preparations for the treatment of fibromyalgia and neuropathic pain disorders" in Class 5 (Reg. No. 3,658,661), for "printed matter, namely, brochures, pamphlets, posters, newsletters, promotional materials, patient educational materials, all concerning the treatment of fibromyalgia and neuropathic pain disorders" in Class 16, and "medical informational services, namely, providing health information in the field of fibromyalgia and neuropathic pain disorders via a

global computer network” in Class 44 (Reg. No. 3,761,078).⁷ The variety of goods and services used with Opposer’s SAVELLA Marks has increased the likelihood of consumer confusion with Applicant’s SEBELA mark. This factor favors Opposer.

I. All Doubts Must be Resolved In Favor of Opposer, Because Confusion of These Two Pharmaceutical Products is Dangerous

The extent of potential confusion, the twelfth du Pont factor, is substantial. It is apparent from the foregoing that the sale of these two pharmaceutical preparations under confusingly similar marks could well result in confusion, which could also have serious consequences. See E.R. Squibb & Sons, Inc., 2000 TTAB LEXIS 216, at *20-21; see also In re Shell Oil Co., 992 F.2d 1204, 26 U.S.P.Q.2d (BNA) 1687 (Fed. Cir. 1993); In re Phoenix Intangibles Holding Co., 2004 TTAB LEXIS 677, *12 (holding that “[t]o the extent that there is any doubt on the issue of likelihood of confusion with respect to either one of the cited registrations, it is settled that such doubt must be resolved in favor of the prior registrants”); San Fernando Electric Mfg. Co., 565 F.2d at 684, 196 U.S.P.Q. 1; Fricks’ Foods, Inc. v. The Mar-Gold Corporation, 57 C.C.P.A. 731, 733, 417 F.2d 1078, 1080, 163 U.S.P.Q. (BNA) 619 (C.C.P.A. 1969) (holding that “doubts are to be resolved against the newcomer and in favor of the prior user”). Following that principle is all the more important where the products in question are pharmaceuticals, because it is imperative that even a slight possibility of confusion should be avoided. In re Merck & Co., Inc., 189 U.S.P.Q. at 355.⁸

⁷ The trademark registrations at Exs. A-B, which identify all of the goods on which the SAVELLA Marks are used, constitute prima facie evidence of use of the SAVELLA Marks as indicated on the registrations. See J. C. Hall Co., 52 C.C.P.A. at 984, 144 U.S.P.Q. (BNA) 435.

⁸ Even when prescription pharmaceuticals are not at issue, the Board has granted summary judgment when the parties’ marks and goods are similar, as they are here. See, e.g., Sentry Chem. Co. v. Cent. Mfg. Co., 2000 TTAB LEXIS 155, *1-2, 9 (finding SENTRA and SENTRY for various cleaning preparations likely to be confused and granting summary judgment). It is well established that similarity in any one of the elements of sound, appearance, or meaning may be sufficient to create likelihood of

J. The Remaining *Du Pont* Factors Are Neutral or Favor Opposer

The remaining du Pont factors, namely the 10th, 11th and 13th factors, are neutral or favor Opposer. There is no settlement or coexistence agreement between the parties, which means that the 10th factor does not apply and is neutral. Furthermore, there is no evidence that Applicant is able to prevent third parties from using SEBELA on their third party goods, which means that the 11th factor does not apply and is neutral.

The 13th factor, “any other established fact probative of the effect of use,” (see In re E. I. du Pont de Nemours & Co., 476 F.2d at 1361) is either neutral or favors Opposer. As set forth in the above Sections I and II (I), the threat of potential harm to the consuming public is so great, that the Board should find this factor favors Opposer. Additionally, Opposer sent Applicant a cease and desist letter (see Ex. H) approximately one month after Applicant filed its intent-to-use application for SEBELA. See Ex. C. Applicant thus had ample warning to withdraw its application before expending any resources to promote, market or develop SEBELA and instead continued with the prosecution of that mark in bad faith. Therefore, the Board should find that the final 13th du Pont factor favors of Opposer, or at least is neutral.

III. ALTERNATIVELY, OPPOSER REQUESTS THAT THE BOARD GRANT OPPOSER PARTIAL SUMMARY JUDGMENT ON THE ISSUES OF STANDING, PRIORITY AND ANY OF THE DUPONT FACTORS WHICH THE BOARD DETERMINES IN FAVOR OF OPPOSER AND TO STRIKE APPLICANT’S SIXTH AFFIRMATIVE DEFENSE

A. Opposer is Entitled to Partial Summary Judgment on Standing, Priority and on the *Du Pont* Factors that Favor Opposer

In the event the Board denies applicant summary judgment on the issue of likelihood of confusion, Opposer respectfully requests the Board grant Opposer partial summary judgment on

confusion. See General Foods Corp. v. Wisconsin Bottling, Inc., 190 U.S.P.Q. (BNA) 43, 45 (T.T.A.B. 1976) (finding TING and TING COLA confusingly similar to TANG breakfast drink.)

the issues of standing, priority and those du Pont factors which the Board determines there is no genuine dispute of fact that Opposer established in its favor. See Great White Shark Enters. v. Brick City 21 LLC, Opp. No. 91,201,911, 2012 TTAB LEXIS 408, *9 (T.T.A.B. Oct. 12, 2012) (where the Board granted opposer partial summary judgment on the issues of standing, priority, relatedness of goods, overlapping channels of trade and classes of purchasers where there was “no genuine dispute of material fact that opposer established its standing, priority, the relatedness of the parties' goods and overlapping channels of trade and classes of purchasers.”).

B. Opposer is Also Entitled to Partial Summary Judgment for the Dismissal of Applicant's Sixth Affirmative Defense Because Applicant Has Admitted It Has No Evidence to Support This Defense

Applicant asserts the following in its Sixth Affirmative Defense:

Opposer's registrations may be invalid, unenforceable, or subject to cancellation, in whole or in part, and Applicant reserves the right to seek the same as further facts are developed through discovery in this proceeding.

SEBELA Opposition (91216969) T.T.A.B. Docket No. 4. Request No. 31 in Opposer's First Request for Admissions stated “[a]pplicant currently has no evidentiary or factual basis to assert that Opposer's SAVELLA registrations may be invalid, unenforceable, or subject to cancellation, in whole or in part.” Ex. I at 7. In response, Applicant stated “[a]pplicant lacks sufficient information to either admit or deny the statement in Request No. 31 and therefore denies same.” Ex. J at 8. The Board should dismiss Applicant's Sixth Affirmative Defense because its response shows that it never had any evidentiary basis to assert its Sixth Affirmative Defense. If Applicant had any good faith basis for its Sixth Affirmative Defense, it would have identified the basis for its defense that the SAVELLA Marks are invalid, unenforceable or subject to cancellation.

CONCLUSION

For the foregoing reasons, Opposer respectfully requests that the Board grant Opposer's motion for summary judgment on the issue likelihood of confusion between the SEBELA Application and the SAVELLA Marks and deny registration of Applicant's SEBELA Application, or, alternatively, to (1) grant Opposer partial summary judgment on the issues of standing, priority and any of the du Pont factors which the Board determines there is no genuine dispute of material fact; and (2) strike Applicant's Sixth Affirmative Defense.

Dated: March 31, 2015

Respectfully submitted,

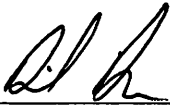
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Attorneys for Opposer

CERTIFICATE OF SERVICE

I hereby certify that true and complete copies of the foregoing Memorandum of Law in Support of Opposer Forest Laboratories, LLC's Motion for Summary Judgement and attached exhibits, have been served on Carrie Shufflebarger, Esq., attorney for Applicant, by mailing said copies on March 31, 2015, via First Class Mail, postage prepaid to:

Carrie Shufflebarger, Esq.
312 Walnut Street
Fourteenth Floor
Cincinnati, Ohio 45202

A handwritten signature in black ink, appearing to read 'D. Rome', is written above a horizontal line.

David Rome

Ex. *A*

Generated on: This page was generated by TSDR on 2015-03-13 19:09:47 EDT

Mark: SAVELLA

SAVELLA

US Serial Number: 77211766
US Registration Number: 3658661
Register: Principal
Mark Type: Trademark
Status: A Sections 8 and 15 combined declaration has been accepted and acknowledged.
Status Date: Aug. 06, 2014
Publication Date: Dec. 04, 2007
Application Filing Date: Jun. 21, 2007
Registration Date: Jul. 21, 2009
Notice of Allowance Date: Feb. 26, 2008

Mark Information

Mark Literal Elements: SAVELLA

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

Goods and Services

Note: The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *..* identify additional (new) wording in the goods/services.

For: pharmaceutical preparations for the treatment of fibromyalgia and neuropathic pain disorders

International Class(es): 005 - Primary Class

U.S Class(es): 006, 018, 044, 046, 051, 052

Class Status: ACTIVE

Basis: 1(a)

First Use: Apr. 24, 2009

Use in Commerce: Apr. 24, 2009

Basis Information (Case Level)

Filed Use: No	Currently Use: Yes	Amended Use: No
Filed ITU: Yes	Currently ITU: No	Amended ITU: No
Filed 44D: No	Currently 44D: No	Amended 44D: No
Filed 44E: No	Currently 44E: No	Amended 44E: No
Filed 66A: No	Currently 66A: No	
Filed No Basis: No	Currently No Basis: No	

Current Owner(s) Information

Owner Name: Forest Laboratories, Inc.
Owner Address: 909 Third Avenue
New York, NEW YORK 10022
UNITED STATES
Legal Entity Type: CORPORATION
State or Country Where Organized: DELAWARE

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Christopher Serbagi
Attorney Primary Email Address: madis48@earthlink.net
Attorney Email Authorized: No

Correspondent

Correspondent Name/Address: Christopher Serbagi
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NEW YORK, NEW YORK 10022-5719
UNITED STATES

Phone: 212-593-2112

Fax: 212-308-8582

Correspondent e-mail: ptoemails@earthlink.net david@serbagilaw.com

Correspondent e-mail Yes
Authorized:

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Aug. 06, 2014	NOTICE OF ACCEPTANCE OF SEC. 8 & 15 - E-MAILED	
Aug. 06, 2014	REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.	76985
Aug. 06, 2014	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	76985
Jul. 21, 2014	TEAS SECTION 8 & 15 RECEIVED	
Jan. 08, 2013	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Jan. 08, 2013	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Jul. 21, 2009	REGISTERED-PRINCIPAL REGISTER	
Jun. 12, 2009	LAW OFFICE REGISTRATION REVIEW COMPLETED	76537
Jun. 08, 2009	ALLOWED PRINCIPAL REGISTER - SOU ACCEPTED	
May 18, 2009	STATEMENT OF USE PROCESSING COMPLETE	70565
Apr. 29, 2009	USE AMENDMENT FILED	70565
May 18, 2009	CASE ASSIGNED TO INTENT TO USE PARALEGAL	70565
Apr. 29, 2009	TEAS STATEMENT OF USE RECEIVED	
Feb. 20, 2009	EXTENSION 2 GRANTED	98765
Feb. 20, 2009	EXTENSION 2 FILED	98765
Feb. 20, 2009	TEAS EXTENSION RECEIVED	
Jul. 31, 2008	EXTENSION 1 GRANTED	98765
Jul. 31, 2008	EXTENSION 1 FILED	98765
Jul. 31, 2008	TEAS EXTENSION RECEIVED	
Feb. 26, 2008	NOA MAILED - SOU REQUIRED FROM APPLICANT	
Dec. 04, 2007	PUBLISHED FOR OPPOSITION	
Nov. 14, 2007	NOTICE OF PUBLICATION	
Oct. 29, 2007	LAW OFFICE PUBLICATION REVIEW COMPLETED	76537
Oct. 29, 2007	ASSIGNED TO LIE	76537
Sep. 27, 2007	APPROVED FOR PUB - PRINCIPAL REGISTER	
Sep. 22, 2007	ASSIGNED TO EXAMINER	78373
Jun. 25, 2007	NEW APPLICATION ENTERED IN TRAM	

Maintenance Filings or Post Registration Information

Affidavit of Continued Use: Section 8 - Accepted

Affidavit of Incontestability: Section 15 - Accepted

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: TMO LAW OFFICE 116

Date in Location: Aug. 06, 2014

Assignment Abstract Of Title Information

Summary

Total Assignments: 1

Registrant: Forest Laboratories, Inc.

Assignment 1 of 1

Conveyance: MERGER AND CHANGE OF NAME EFFECTIVE 02/17/2014

Reel/Frame: [5363/0776](#)

Pages: 9

Date Recorded: Sep. 16, 2014

Supporting Documents: [assignment-tm-5363-0776.pdf](#)

Assignor

Name: [FOREST LABORATORIES, INC.](#) Execution Date: Feb. 17, 2014
Legal Entity Type: CORPORATION State or Country Where Organized: DELAWARE

Name: [TANGO MERGER SUB 2 LLC](#) Execution Date: Feb. 17, 2014
Legal Entity Type: LIMITED LIABILITY COMPANY State or Country Where Organized: DELAWARE

Assignee

Name: [FOREST LABORATORIES, LLC](#)
Legal Entity Type: LIMITED LIABILITY COMPANY State or Country Where Organized: DELAWARE

Address: MORRIS CORPORATE CENTER III
400 INTERSPACE PARKWAY
PARSIPPANY, NEW JERSEY 07054

Correspondent

Correspondent Name: CHRISTOPHER SERBAGI
Correspondent Address: 488 MADISON AVENUE
SUITE 1120
NEW YORK, NY 10022

Domestic Representative - Not Found

Proceedings

Summary

Number of Proceedings: 3

Type of Proceeding: Opposition

Proceeding Number: [91216969](#) Filing Date: Jun 19, 2014
Status: Pending Status Date: Jun 19, 2014
Interlocutory Attorney: GEORGE POLOGEORGIS

Defendant

Name: Sebela International Limited
Correspondent Address: CARRIE A SHUFFLEBARGER
THOMPSON HINE LLP
312 WALNUT STREET FOURTEENTH FLOOR
CINCINNATI OH , 45202
UNITED STATES
Correspondent e-mail: carrie.shufflebarger@thompsonhine.com , ipdocket@thompsonhine.com , ash.patel@thompsonhine.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
SEBELA	Opposition Pending	86127398	

Plaintiff(s)

Name: Forest Laboratories, Inc.
Correspondent Address: CHRISTOPHER SERBAGI
THE SERBAGI LAW FIRM PC
488 MADISON AVENUE, SUITE 1120
NEW YORK NY , 10022
UNITED STATES
Correspondent e-mail: ptoemails@earthlink.net , david@serbagilaw.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
SAVELLA	Section 8 and 15 - Accepted and Acknowledged	77211766	3658661
SAVELLA	Registered	77795756	3761078

Prosecution History

Entry Number	History Text	Date	Due Date
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1	FILED AND FEE	Jun 19, 2014	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Jun 19, 2014	Jul 29, 2014
3	PENDING, INSTITUTED	Jun 19, 2014	
4	ANSWER	Jul 28, 2014	
5	P MOT TO JOIN/SUBSTITUTE PARTY	Oct 10, 2014	
6	TRIAL DATES REMAIN AS SET	Oct 23, 2014	
7	STIP FOR EXT	Jan 06, 2015	
8	EXTENSION OF TIME GRANTED	Jan 06, 2015	
9	STIP FOR EXT	Feb 26, 2015	
10	EXTENSION OF TIME GRANTED	Feb 26, 2015	

Type of Proceeding: Opposition

Proceeding Number: [91209923](#)

Filing Date: Mar 25, 2013

Status: Terminated

Status Date: Jul 07, 2013

Interlocutory Attorney: JENNIFER KRISP

Defendant

Name: Apothecary Holdings, Inc. AKA The Apothecary Shops

Correspondent Address: SEAN D JOHNSON
INGRASSIA FISHER & LORENZ PC
7010 E COCHISE RD
SCOTTSDALE AZ , 85085-1322
UNITED STATES

Correspondent e-mail: Sjohnson@ifllaw.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
AVELLA INC.	Third Extension - Granted	85606899	
AVELLA HEALTH VIA EXCELLENCE	Third Extension - Granted	85618429	

Plaintiff(s)

Name: Forest Laboratories, Inc.

Correspondent Address: CHRISTOPHER SERBAGI
THE SERBAGI LAW FIRM PC
488 MADISON AVENUE, STE 1120
NEW YORK NY , 10022
UNITED STATES

Correspondent e-mail: christopher@serbagilaw.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
SAVELLA	Section 8 and 15 - Accepted and Acknowledged	77211766	3658661
SAVELLA	Registered	77795756	3761078

Prosecution History

Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Mar 25, 2013	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Mar 25, 2013	May 04, 2013
3	PENDING, INSTITUTED	Mar 25, 2013	
4	STIP TO SUSP PEND SETTL NEGOTIATIONS	May 02, 2013	
5	SUSPENDED	May 02, 2013	
6	MOT TO AMEND APPLICATION	May 20, 2013	
7	RESPONSE DUE 30 DAYS (DUE DATE)	Jun 14, 2013	Jul 14, 2013
8	W/DRAW OF OPPOSITION	Jun 20, 2013	
9	BD DECISION: DISMISSED W/ PREJ	Jul 07, 2013	
10	TERMINATED	Jul 07, 2013	

Type of Proceeding: Opposition

Proceeding Number: [91206078](#)

Filing Date: Jul 15, 2012

Status: Terminated

Status Date: Aug 27, 2012

Interlocutory Attorney: MICHAEL B ADLIN

Defendant

Name: Novartis AG

Correspondent Address: MAURY M TEPPER III
TEPPER & EYSTER PLLC
3724 BENSON DRIVE
RALEIGH NC , 27609-7321
UNITED STATES

Correspondent e-mail: mtepper@teiplaw.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
REVELLA	Fourth Extension - Granted	85417711	

Plaintiff(s)

Name: Forest Laboratories, Inc.

Correspondent Address: CHRISTOPHER SERBAGI
THE SERBAGI LAW FIRM PC
488 MADISON AVENUE, SUITE 1120
NEW YORK NY , 11201
UNITED STATES

Correspondent e-mail: madis48@earthlink.net , david@serbagilaw.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
SAVELLA	Section 8 and 15 - Accepted and Acknowledged	77211766	3658661
SAVELLA	Registered	77795756	3761078

Prosecution History

Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Jul 15, 2012	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Jul 15, 2012	Aug 24, 2012
3	PENDING, INSTITUTED	Jul 15, 2012	
4	WITHDRAWAL OF OPPOSITION	Aug 23, 2012	
5	BD'S DECISION: DISMISSED W/ PREJUDICE	Aug 27, 2012	
6	TERMINATED	Aug 27, 2012	

Ex. B

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Mark: SAVELLA



US Serial Number: 77795756
US Registration Number: 3761078
Register: Principal
Mark Type: Trademark, Service Mark
Status: Registered. The registration date is used to determine when post-registration maintenance documents are due.
Status Date: Mar. 16, 2010
Publication Date: Dec. 29, 2009

Application Filing Date: Aug. 03, 2009

Registration Date: Mar. 16, 2010

Mark Information

Mark Literal Elements: SAVELLA
Standard Character Claim: No
Mark Drawing Type: 3 - AN ILLUSTRATION DRAWING WHICH INCLUDES WORD(S)/ LETTER(S)/NUMBER(S)
Description of Mark: The mark consists of "SAVELLA" followed by two curved lines on top of three curved lines.
Color(s) Claimed: Color is not claimed as a feature of the mark.
Design Search Code(s): 26.17.02 - Bands, wavy; Bars, wavy; Lines, wavy; Wavy line(s), band(s) or bar(s)
26.17.06 - Bands, diagonal; Bars, diagonal; Lines, diagonal; Diagonal line(s), band(s) or bar(s)
26.17.09 - Bands, curved; Curved line(s), band(s) or bar(s); Bars, curved; Lines, curved

Related Properties Information

International Registration Number: 1014929
International Application(s) /Registration(s) Based on this Property: A0017059, A0017071/1014929

Goods and Services

Note: The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis (()) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks "*" identify additional (new) wording in the goods/services.

For: printed matter, namely, brochures, pamphlets, posters, newsletters, promotional materials, patient educational materials, all concerning the treatment of fibromyalgia and neuropathic pain disorders

International Class(es): 016 - Primary Class

U.S Class(es): 002, 005, 022, 023, 029, 037, 038, 050

Class Status: ACTIVE

Basis: 1(a)

First Use: May 17, 2009

Use in Commerce: May 17, 2009

For: medical informational services, namely, providing health information in the field of fibromyalgia and neuropathic pain disorders via a global computer network

International Class(es): 044 - Primary Class

U.S Class(es): 100, 101

Class Status: ACTIVE

Basis: 1(a)

First Use: Jan. 15, 2009

Use in Commerce: Jan. 15, 2009

Basis Information (Case Level)

Filed Use: Yes

Currently Use: Yes

Amended Use: No

Filed ITU: No

Currently ITU: No

Amended ITU: No

Filed 44D: No

Currently 44D: No

Amended 44D: No

Filed 44E: No

Currently 44E: No

Amended 44E: No

Filed 66A: No

Currently 66A: No

Filed No Basis: No

Currently No Basis: No

Current Owner(s) Information

Owner Name: Forest Laboratories, Inc.

Owner Address: 909 Third Avenue
New York, NEW YORK 10022
UNITED STATES

Legal Entity Type: CORPORATION

State or Country Where Organized: DELAWARE

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Christopher Serbagi

Attorney Primary Email Address: madis48@earthlink.net

Attorney Email Authorized: No

Correspondent

Correspondent Name/Address: Christopher Serbagi
THE SERBAGI LAW FIRM
488 MADISON AVE STE 1120
NEW YORK, NEW YORK 10022-5719
UNITED STATES

Phone: 212-593-2112

Fax: 212-308-8582

Correspondent e-mail: ptoemails@earthlink.net david@serbagilaw.com

Correspondent e-mail Authorized: Yes

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Jan. 08, 2013	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Jan. 08, 2013	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Mar. 16, 2010	REGISTERED-PRINCIPAL REGISTER	
Dec. 29, 2009	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
Dec. 29, 2009	PUBLISHED FOR OPPOSITION	
Nov. 24, 2009	LAW OFFICE PUBLICATION REVIEW COMPLETED	74215
Nov. 24, 2009	ASSIGNED TO LIE	74215
Nov. 06, 2009	APPROVED FOR PUB - PRINCIPAL REGISTER	
Nov. 05, 2009	ASSIGNED TO EXAMINER	69197
Aug. 08, 2009	NOTICE OF DESIGN SEARCH CODE MAILED	
Aug. 07, 2009	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Aug. 06, 2009	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: PUBLICATION AND ISSUE SECTION

Date in Location: Mar. 16, 2010

Assignment Abstract Of Title Information

Summary

Total Assignments: 1

Registrant: Forest Laboratories, Inc.

Assignment 1 of 1

Conveyance: MERGER AND CHANGE OF NAME EFFECTIVE 02/17/2014

Reel/Frame: [5363/0776](#)

Pages: 9

Date Recorded: Sep. 16, 2014

Supporting Documents: [assignment-tm-5363-0776.pdf](#)

Assignor

Name: [FOREST LABORATORIES, INC.](#)

Execution Date: Feb. 17, 2014

Legal Entity Type: CORPORATION

State or Country Where
Organized: DELAWARE

Name: [TANGO MERGER SUB 2 LLC](#)

Execution Date: Feb. 17, 2014

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country Where
Organized: DELAWARE

Assignee

Name: [FOREST LABORATORIES, LLC](#)

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country Where
Organized: DELAWARE

Address: MORRIS CORPORATE CENTER III
400 INTERSPACE PARKWAY
PARSIPPANY, NEW JERSEY 07054

Correspondent

Correspondent Name: CHRISTOPHER SERBAGI

Correspondent Address: 488 MADISON AVENUE
SUITE 1120
NEW YORK, NY 10022

Domestic Representative - Not Found

Proceedings

Summary

Number of Proceedings: 3

Type of Proceeding: Opposition

Proceeding Number: [91216969](#)

Filing Date: Jun 19, 2014

Status: Pending

Status Date: Jun 19, 2014

Interlocutory Attorney: GEORGE POLOGEORGIS

Defendant

Name: Sebela International Limited

Correspondent Address: CARRIE A SHUFFLEBARGER
THOMPSON HINE LLP
312 WALNUT STREET FOURTEENTH FLOOR
CINCINNATI OH , 45202
UNITED STATES

Correspondent e-mail: carrie.shufflebarger@thompsonhine.com , ipdocket@thompsonhine.com , ash.patel@thompsonhine.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
SEBELA	Opposition Pending	86127398	

Plaintiff(s)

Name: Forest Laboratories, Inc.

Correspondent Address: CHRISTOPHER SERBAGI
THE SERBAGI LAW FIRM PC
488 MADISON AVENUE, SUITE 1120
NEW YORK NY , 10022
UNITED STATES

Correspondent e-mail: ptoemails@earthlink.net , david@serbagilaw.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
SAVELLA	Section 8 and 15 - Accepted and Acknowledged	77211766	3658661
SAVELLA	Registered	77795756	3761078

Prosecution History

Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Jun 19, 2014	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Jun 19, 2014	Jul 29, 2014
3	PENDING, INSTITUTED	Jun 19, 2014	
4	ANSWER	Jul 28, 2014	
5	P MOT TO JOIN/SUBSTITUTE PARTY	Oct 10, 2014	

6	TRIAL DATES REMAIN AS SET	Oct 23, 2014
7	STIP FOR EXT	Jan 06, 2015
8	EXTENSION OF TIME GRANTED	Jan 06, 2015
9	STIP FOR EXT	Feb 26, 2015
10	EXTENSION OF TIME GRANTED	Feb 26, 2015

Type of Proceeding: Opposition

Proceeding Number: [91209923](#)

Filing Date: Mar 25, 2013

Status: Terminated

Status Date: Jul 07, 2013

Interlocutory Attorney: JENNIFER KRISP

Defendant

Name: Apothecary Holdings, Inc. AKA The Apothecary Shops

Correspondent Address: SEAN D JOHNSON
INGRASSIA FISHER & LORENZ PC
7010 E COCHISE RD
SCOTTSDALE AZ , 85085-1322
UNITED STATES

Correspondent e-mail: Sjohnson@ifllaw.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
AVELLA INC.	Third Extension - Granted	85606899	
AVELLA HEALTH VIA EXCELLENCE	Third Extension - Granted	85618429	

Plaintiff(s)

Name: Forest Laboratories, Inc.

Correspondent Address: CHRISTOPHER SERBAGI
THE SERBAGI LAW FIRM PC
488 MADISON AVENUE, STE 1120
NEW YORK NY , 10022
UNITED STATES

Correspondent e-mail: christopher@serbagilaw.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
SAVELLA	Section 8 and 15 - Accepted and Acknowledged	77211766	3658661
SAVELLA	Registered	77795756	3761078

Prosecution History

Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Mar 25, 2013	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Mar 25, 2013	May 04, 2013
3	PENDING, INSTITUTED	Mar 25, 2013	
4	STIP TO SUSP PEND SETTL NEGOTIATIONS	May 02, 2013	
5	SUSPENDED	May 02, 2013	
6	MOT TO AMEND APPLICATION	May 20, 2013	
7	RESPONSE DUE 30 DAYS (DUE DATE)	Jun 14, 2013	Jul 14, 2013
8	W/DRAW OF OPPOSITION	Jun 20, 2013	
9	BD DECISION: DISMISSED W/ PREJ	Jul 07, 2013	
10	TERMINATED	Jul 07, 2013	

Type of Proceeding: Opposition

Proceeding Number: [91206078](#)

Filing Date: Jul 15, 2012

Status: Terminated

Status Date: Aug 27, 2012

Interlocutory Attorney: MICHAEL B ADLIN

Defendant

Name: Novartis AG

Correspondent Address: MAURY M TEPPER III
TEPPER & EYSTER PLLC
3724 BENSON DRIVE

RALEIGH NC , 27609-7321
UNITED STATES

Correspondent e-mail: mtepper@teiplaw.com

Associated marks			
Mark	Application Status	Serial Number	Registration Number
REVELLA	Fourth Extension - Granted	85417711	
Plaintiff(s)			

Name: Forest Laboratories, Inc.

Correspondent Address: CHRISTOPHER SERBAGI
THE SERBAGI LAW FIRM PC
488 MADISON AVENUE, SUITE 1120
NEW YORK NY , 11201
UNITED STATES

Correspondent e-mail: madis48@earthlink.net , david@serbagilaw.com

Associated marks			
Mark	Application Status	Serial Number	Registration Number
SAVELLA	Section 8 and 15 - Accepted and Acknowledged	77211766	3658661
SAVELLA	Registered	77795756	3761078

Prosecution History			
Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Jul 15, 2012	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Jul 15, 2012	Aug 24, 2012
3	PENDING, INSTITUTED	Jul 15, 2012	
4	WITHDRAWAL OF OPPOSITION	Aug 23, 2012	
5	BD'S DECISION: DISMISSED W/ PREJUDICE	Aug 27, 2012	
6	TERMINATED	Aug 27, 2012	

Ex. C

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Mark: SEBELA

SEBELA

US Serial Number: 86127398

Application Filing Date: Nov. 22, 2013

Register: Principal

Mark Type: Trademark

Status: An opposition after publication is pending at the Trademark Trial and Appeal Board. For further information, see TTABVue on the Trademark Trial and Appeal Board web page.

Status Date: Jun. 19, 2014

Publication Date: Apr. 22, 2014

Mark Information

Mark Literal Elements: SEBELA

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

Goods and Services

Note: The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis (()) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *..* identify additional (new) wording in the goods/services.

For: Medicated and pharmaceutical preparations, both prescription and over-the-counter, for use in dermatology; and, medicated and pharmaceutical preparations, both prescription and over-the-counter, for use in gastroenterology

International Class(es): 005 - Primary Class

U.S Class(es): 006, 018, 044, 046, 051, 052

Class Status: ACTIVE

Basis: 1(b)

Basis Information (Case Level)

Filed Use: No

Currently Use: No

Amended Use: No

Filed ITU: Yes

Currently ITU: Yes

Amended ITU: No

Filed 44D: No

Currently 44D: No

Amended 44D: No

Filed 44E: No

Currently 44E: No

Amended 44E: No

Filed 66A: No

Currently 66A: No

Filed No Basis: No

Currently No Basis: No

Current Owner(s) Information

Owner Name: Sebel International Limited

Owner Address: H.P. House
21 Laffan Street
Hamilton HM09
BERMUDA

Legal Entity Type: limited company (ltd.)

**State or Country Where
Organized:** IRELAND

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Ashish D. Patel

**Attorney Primary Email
Address:** ipdocket@thompsonhine.com

**Attorney Email
Authorized:** Yes

Correspondent

**Correspondent
Name/Address:** CARRIE A SHUFFLEBARGER
THOMPSON HINE LLP
312 WALNUT STREET FOURTEENTH FLOOR
CINCINNATI, OHIO 45202

UNITED STATES

Phone: 404.407.3607

Fax: 404.541.2905

Correspondent e-mail: ipdocket@thompsonhine.com

Correspondent e-mail Yes
Authorized:

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Jun. 19, 2014	OPPOSITION INSTITUTED NO. 999999	216969
Apr. 29, 2014	EXTENSION OF TIME TO OPPOSE RECEIVED	
Apr. 22, 2014	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
Apr. 22, 2014	PUBLISHED FOR OPPOSITION	
Apr. 02, 2014	NOTIFICATION OF NOTICE OF PUBLICATION E-MAILED	
Mar. 15, 2014	APPROVED FOR PUB - PRINCIPAL REGISTER	77657
Mar. 08, 2014	ASSIGNED TO EXAMINER	
Dec. 07, 2013	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Nov. 26, 2013	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information	
TM Attorney: SOMERVILLE, ARETHA CHA	Law Office Assigned: LAW OFFICE 107
File Location	
Current Location: PUBLICATION AND ISSUE SECTION	Date in Location: Mar. 17, 2014

Assignment Abstract Of Title Information

Summary	
Total Assignments: 2	Applicant: Sebela International Limited
Assignment 1 of 2	
Conveyance: SECURITY INTEREST	
Reel/Frame: 5339/0952	Pages: 7
Date Recorded: Aug. 08, 2014	
Supporting Documents: assignment-tm-5339-0952.pdf	
Assignor	
Name: SEBELA INTERNATIONAL LIMITED	Execution Date: Aug. 07, 2014
Legal Entity Type: LIMITED COMPANY (LTD.)	State or Country Where Organized: IRELAND
Assignee	
Name: GENERAL ELECTRIC CAPITAL CORPORATION, AS AGENT	
Legal Entity Type: CORPORATION	State or Country Where Organized: DELAWARE
Address: 2 BETHESDA METRO CENTER, SUITE 600 BETHESDA, MARYLAND 20814	
Correspondent	
Correspondent Name: KAREN OSBORNE, SENIOR PARALEGAL	
Correspondent Address: 1180 PEACHTREE STREET, N.E. KING & SPALDING LLP ATLANTA, GA 30309	
Domestic Representative - Not Found	
Assignment 2 of 2	
Conveyance: SECURITY INTEREST	
Reel/Frame: 5348/0399	Pages: 7
Date Recorded: Aug. 20, 2014	
Supporting Documents: assignment-tm-5348-0399.pdf	
Assignor	
Name: SEBELA INTERNATIONAL LIMITED	Execution Date: Aug. 15, 2014

Legal Entity Type: LIMITED COMPANY

State or Country Where
Organized: IRELAND

Assignee

Name: [GENERAL ELECTRIC CAPITAL CORPORATION, AS ADMINISTRATIVE AGENT](#)

Legal Entity Type: CORPORATION

State or Country Where
Organized: DELAWARE

Address: 2 BETHESDA METRO CENTER
SUITE 600
BETHESDA, MARYLAND 20814

Correspondent

Correspondent Name: CAROL FRASER, PARALEGAL

Correspondent Address: 1180 PEACHTREE STREET
KING & SPALDING
ATLANTA, GA 30309-3521

Domestic Representative - Not Found

Proceedings

Summary

Number of Proceedings: 2

Type of Proceeding: Opposition

Proceeding Number: [91216969](#)

Filing Date: Jun 19, 2014

Status: Pending

Status Date: Jun 19, 2014

Interlocutory Attorney: GEORGE POLOGEORGIS

Defendant

Name: Sebela International Limited

Correspondent Address: CARRIE A SHUFFLEBARGER
THOMPSON HINE LLP
312 WALNUT STREET FOURTEENTH FLOOR
CINCINNATI OH , 45202
UNITED STATES

Correspondent e-mail: carrie.shufflebarger@thompsonhine.com , ipdocket@thompsonhine.com , ash.patel@thompsonhine.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
SEBELA	Opposition Pending	86127398	

Plaintiff(s)

Name: Forest Laboratories, Inc.

Correspondent Address: CHRISTOPHER SERBAGI
THE SERBAGI LAW FIRM PC
488 MADISON AVENUE, SUITE 1120
NEW YORK NY , 10022
UNITED STATES

Correspondent e-mail: ptoemails@earthlink.net , david@serbagilaw.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
SAVELLA	Section 8 and 15 - Accepted and Acknowledged	77211766	3658661
SAVELLA	Registered	77795756	3761078

Prosecution History

Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Jun 19, 2014	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Jun 19, 2014	Jul 29, 2014
3	PENDING, INSTITUTED	Jun 19, 2014	
4	ANSWER	Jul 28, 2014	
5	P MOT TO JOIN/SUBSTITUTE PARTY	Oct 10, 2014	
6	TRIAL DATES REMAIN AS SET	Oct 23, 2014	
7	STIP FOR EXT	Jan 06, 2015	
8	EXTENSION OF TIME GRANTED	Jan 06, 2015	

9 STIP FOR EXT Feb 26, 2015
10 EXTENSION OF TIME GRANTED Feb 26, 2015

Type of Proceeding: Extension of Time

Proceeding Number: [86127398](#)

Filing Date: Apr 29, 2014

Status: Terminated

Status Date: Jun 21, 2014

Interlocutory Attorney:

Defendant

Name: Sebela International Limited

Correspondent Address: ASHISH D. PATEL
THOMPSON HINE LLP
10050 INNOVATION DR
MIAMISBURG OH , 45342-4931

Associated marks

Mark	Application Status	Serial Number	Registration Number
SEBELA	Opposition Pending	86127398	

Potential Opposer(s)

Name: Forest Laboratories, Inc.

Correspondent Address: Christopher Serbagi
The Serbagi Law Firm, P.C.
488 Madison Avenue, Suite 1120
New York NY , 10022
UNITED STATES

Correspondent e-mail: ptoemails@earthlink.net

Associated marks

Mark	Application Status	Serial Number	Registration Number
------	--------------------	---------------	---------------------

Prosecution History

Entry Number	History Text	Date	Due Date
1	INCOMING - EXT TIME TO OPPOSE FILED	Apr 29, 2014	
2	EXTENSION OF TIME GRANTED	Apr 29, 2014	

Ex. D



E.R. Squibb & Sons, Inc. v. Kos Pharmaceuticals, Inc.

Opposition No. 101,510 to application Serial No. 74/546,967 filed on July 7, 1994

Trademark Trial and Appeal Board

2000 TTAB LEXIS 216

September 29, 1999, Hearing

April 14, 2000, Decided

DISPOSITION:

[*1]

Decision: Accordingly, the opposition is hereby sustained and registration to applicant is refused.

COUNSEL:

Bruce R. Ewing of Dorsey & Whitney LLP for E.R. Squibb & Sons, Inc.

Reese Taylor of Renner Kenner Greive Bobak Taylor & Weber for Kos Pharmaceuticals, Inc.

JUDGES: Before Bucher, Bottorff and McLeod, Administrative Trademark Judges.

OPINION BY: Bucher, David E.

OPINION:

THIS DISPOSITION IS NOT CITABLE AS PRECEDENT OF THE T.T.A.B.

Opinion by Bucher, Administrative Trademark Judge:

Kos Pharmaceuticals, Inc., a Florida corporation, filed an application to register the mark "NICOSTATIN" on the principal register for a "pharmaceutical preparation for treatment of hyperlipidemia." n1 E.R. Squibb & Sons, Inc., a Delaware corporation, filed a timely notice of opposition on December 4, 1995. As grounds for opposition, opposer asserted prior use of the registered trademark "MYCOSTATIN" for an "antibiotic preparation." n2 Opposer asserted that it has marketed its closely related pharmaceutical preparation under its "MYCOSTATIN" mark for many years, thereby deriving substantial goodwill for opposer. Given the similarity in the marks, opposer charges that applicant's mark, as applied to applicant's [*2] goods, so resembles opposer's mark that confusion is likely under Section 2(d) of the Lanham Act.

n1 Serial No. 74/546,967, in International Class 5, filed July 7, 1994, based upon an allegation of a *bona*

fide intention to use the mark in commerce.

n2 Reg. No. 599,575, issued on the Principal Register on December 21, 1954; second renewal in 1994. Opposer, E.R. Squibb & Sons, Inc., has its own history dating back to the nineteenth century, but continues as one of many domestic subsidiaries of the pharmaceutical giant, Bristol-Myers Squibb, Inc.

Applicant, in its answer, has admitted that it filed the instant application, but has otherwise denied the essential allegations of the notice of opposition.

A trial was conducted and legal briefs have been filed. Both parties were represented by counsel at an oral hearing before this Board.

Summary of the Record and Procedural Rulings

The record includes the instant application of Kos Pharmaceuticals, Inc.; as part of opposer's case-in-chief, a copy of applicant's responses to opposer's interrogatories, and the material submitted thereunder, excerpts from the discovery depositions of David Bova, applicant's [*3] officer, and selected exhibits submitted therewith, and a collection of articles from medical journals and other printed publications, all introduced under a notice of reliance pursuant to 37 C.F.R. 2.120(j)(3)(i). Opposer, as the rest of its case-in-chief, submitted the testimony, with exhibits, of Denise Fishback, senior director of marketing for Westwood-Squibb Pharmaceuticals, Inc. n3, Gloria Chambers, associate director of marketing for Bristol-Myers Squibb Oncology Division, n4 and Jonathan Zalk, product manager in Bristol-Myers Squibb's Apothecon division; n5 opposer submitted a collection of stipulated exhibits as well as notice of reliance upon a certified title and status copy of its "MYCOSTATIN" registration demonstrating that it is subsisting and owned by opposer. Portions of the testimony and exhibits have been designated "Confidential" pursuant to a protective order, including certain responses to discovery requests, exhibits, portions of deposition transcripts, and portions of the parties' briefs.

n3 According to her testimony, Westwood Squibb is a domestic subsidiary of Bristol-Myers Squibb, and is responsible for the cream and powder forms of Mycostatin.

n4 Bristol-Myers Oncology Therapeutic Network, Inc. is also another domestic subsidiary of Bristol-Myers Squibb, Inc., and is responsible for the lozenge form of Mycostatin.

n5 Apothecon, Inc. is the fourth domestic subsidiary of Bristol-Myers Squibb, Inc. introduced during the course of this trial, and is responsible for the oral suspension and tablet forms of Mycostatin.

[*4]

Applicant did not take any testimony during its testimony period but submitted a copy of some of opposer's responses to applicant's interrogatories introduced under a notice of reliance pursuant to 37 C.F.R. 2.120(j)(3)(i), as well as other parts of the Bova discovery deposition supported by a written statement explaining why applicant needed to rely upon each additional part pursuant to the fairness exception of 37 CFR § 2.120(j)(4), copies of various printed publications and the results of on-line, computer generated queries.

Specifically, applicant seeks to introduce by way of its notice of reliance the results of trademark searches of the Dialog/TrademarkScan database, as well as brief excerpts from several publications (Exhibit 11). Opposer has asked us to exclude this material in its entirety from the record.

Essentially, opposer contends that the search report is hearsay and irrelevant to our likelihood of confusion determination. While we have excluded the search report from consideration, it is for reasons different than those cited by opposer.

We find that a trademark search report constitutes neither a printed publication [*5] of general circulation nor an official record within the contemplation of Trademark Rule 2.122(e), and therefore is not proper subject matter for a notice of reliance. Moreover, the Board will not consider copies of a trademark search report of information taken from a private company's database as credible evidence of the existence of the registrations cited therein. *See Riceland Foods Inc. v. Pacific Eastern Trading Corp.*, 26 USPQ2d 1883 (TTAB 1983). In order to make third-party registrations of record, soft copies of the registrations themselves, or the electronic equivalent thereof, i.e., printouts of the registrations taken from the electronic records of the U.S. Patent and Trademark Office's own database, must be submitted. *See In re Smith and Mehaffey*, 31 USPQ2d 1531 (TTAB 1994); *In re Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230, 1232 (TTAB 1992); *In re Hub Distributing, Inc.*, 218 USPQ 284 (TTAB 1983); and TBMP § 703.02(b).

Further, this report is not adequate to show use of any mark listed therein. *See Tiffany & Co. v. Classic Motor Carriages Inc.*, 10 USPQ2d 1835, 1839 at n. 5 (TTAB 1989) [*6] ["... the probative value of such reports is limited, since the reports do not indicate the extent to which a company's name is used or what opportunity the public has had to become aware of any use."].

Hence, that portion of Exhibit 11 listing various entries of marks containing "myco-," "nico-," and/or "-stat.in-" form no part of the record herein. We hasten to add, however, that even if this exhibit were of record, it would make no difference in the disposition of this case.

The second part of opposer's objection to applicant's Exhibit 11 is that the materials from the printed publications are of questionable relevance, and that given their brevity, are bereft of any real context. We find that many of these entries are extracted from printed publications of general circulation, and hence are appropriate for a notice of reliance. Some of them appear to be relevant to the issues at hand, but we agree with opposer that their brevity limits their probative value. In any case, whatever can be gleaned from this computer-generated search seems cumulative to other information appropriately made of record by one or both of the parties.

Priority is not an issue herein [*7]

The sole issue before us is whether confusion is likely. Priority is not in issue with respect to the marks and goods shown herein in view of opposer's testimony and opposer's ownership of a valid and subsisting registration. *See King Candy Co. v. Eunice King's Kitchen*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974) and *McDonald's Corp. v. McClain*, 37 USPQ2d 1274 (TTAB 1995). Furthermore, at the time the record was closed in this trial, applicant had not yet made any claim of actually using this intended mark.

Likelihood of Confusion Analysis

In the course of rendering this decision, we have followed the guidance of *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1362, 177 USPQ 563, 567-68 (CCPA 1973), that sets forth the factors which should be considered, if relevant, in determining likelihood of confusion.

The marks:

Hence, we turn first to the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression.

Opposer takes the position that:

Here, the visual and aural similarities between MYCOSTATIN [*8] (R) and NICOSTATIN are glaring. Both words are arbitrary terms that contain four syllables, the last three of which are identical. The first syllable of Opposer's mark is pronounced just as it appears ... while the first syllable of Applicant's proposed mark is certainly capable of being pronounced like the first syllable of "nitrogen" or "Niagara." When the first syllables of the two marks are pronounced in this manner, the only aural differences

between them are the similarly sounding letters "N" and "M," which are themselves difficult to distinguish." (Opposer's brief, p. 16).

By contrast, applicant argues that any similarity between these marks is due principally to the common suffix "-statin." Applicant goes on to say that:

Here, the prefixes "MYCO" and "NICO," ... look unlike, are spelled differently and are phonetically dissimilar, and, in this case, would suggest to the doctor or pharmacist that the products are different and have different uses.

Applicant has argued that inasmuch as the derivation of "nico-," the first two syllables of its proposed mark, is from nicotinic acid, it is more likely that the first syllable of the mark will be pronounced with a [*9] short "i" sound. Opposer, on the other hand, argues that because the product's derivation includes "niacin," it is more likely that the first letter "i" in applicant's mark would be pronounced with a long "i" sound, quite like the first syllable in "mycostatin."

Of course, under trademark law, there is no "correct" pronunciation of a coined mark like "nicostatin." See *Barton Mfg. Co. v. Hercules Powder Co.*, 88 F.2d 708, 710, 33 USPQ 105, 107 (CCPA 1937) ["DYANSHINE" and "DISHINE"]; *The Mennen Company v. Yamanouchi Pharmaceutical Co., Ltd.*, 203 USPQ 302 (TTAB 1979) ["MINON" resembles "MENNEN"]; *Eli Lilly And Company v. Burlington Pharmacal, Inc.*, 161 USPQ 370 (TTAB 1969) ["AMOSSED" resembles "AMESEC"]. Hence, if the first syllable of "Nicostatin" and of "Mycostatin" are both pronounced with a long "i" sound, we agree with opposer "...that the only aural differences between them are the similarly sounding letters 'N' and 'M,' which are themselves difficult to distinguish."

As to the respective connotations of the two marks, the parties likewise reach opposite conclusions. Applicant argues that these marks are both [*10] suggestive, with "myco-" coming to us from the Greek word for fungus, and "nico-" derived from a critical component of this pharmaceutical combination, nicotinic acid (or niacin). However, opposer points out that several of the witnesses involved in marketing and brand management on behalf of Bristol-Myers Squibb's various divisions did not know the derivations of the term "myco-" alone. Indeed, it seems when the "myco-" prefix (or the "nico-" prefix) is combined with the "statin" suffix, whatever suggestiveness the components contained are completely lost, perhaps even to those who have analyzed the respective marks with scrupulous care. Neither combination produces a mark that is in any way inherently lacking in trademark significance. The fact that opposer's marketing managers did not know the significance of the "myco-" derivations suggests to us that members of the relevant public even less familiar with opposer's product should not be compelled to resort to a study of etymology in order to avoid mistake or confusion. n6

n6 Testimony deposition of Denise Fishback, p. 39., and testimony deposition of Gloria Chambers, p. 13.

Finally, as to appearance, while the first two [*11] letters of these marks are visibly different, we do not find that determinative in light of the fact that the last three syllables are identical, and given the strong aural similarity noted above.

In sum, this all-important *du Pont* factor favors opposer herein.

The goods:

Opposer's MYCOSTATIN is a preparation sold for the treatment of cutaneous or mucocutaneous fungal infections caused by *Candida albicans* and other species of *Candida*, including diaper rash. Applicant's NICOSTATIN is intended for the treatment of hyperlipidemia, or an excess of fat or lipids in the blood. Hence, both are prescription medications having quite different indications. These two medicaments would clearly not be competitive, but that alone is not determinative as to the relatedness of the goods. Both would be available in oral forms, and the testimony herein confirms that there could be an overlap in their usage since an adult with a *Candida* fungal infections as well as

hyperlipidemia may well end up having both medications prescribed simultaneously. Hence, we find that this critical *du Pont* factor also favors opposer herein.

***Channels of Trade* [*12] :**

Although these two medications do differ in chemical composition, both pharmaceutical preparations can be administered in tablet form for oral use, and are sold only on the prescription of a physician. They will both be promoted to physicians and pharmacists through advertisements in medical and pharmaceutical journals, by direct mailings and by personal visits to physicians on the part of the pharmaceutical houses' respective sales forces. Thus, these products move and are promoted through the same channels of distribution, as are all other ethical pharmaceuticals. As a result, we find a significant area of overlap in the established, likely-to-continue trade channels. Accordingly, this *du Pont* factor also favors opposer.

Particular conditions: - "Extra Care" for pharmaceuticals?

In looking at the conditions under which, and buyers to whom, sales are made, we are not here faced with ordinary consumer goods, but rather are deliberating a question of public health. The trademark doctrine of "Extra Care" or "Greater Care" for pharmaceuticals stands for the proposition that when the consequences of confusion are much more serious, relief should be granted [*13] to the senior user upon a lesser proof of confusing similarity in a prescription drug case than in other areas of trademark litigation. Both logic and sound policy support this result.

The result of confusion could be physical injury to members of the consuming public, whether through adverse reaction to inadvertently prescribed or dispensed drugs, or through simple failure to receive effective medications. For even if it has not been established in the record herein that harmful effects could result from confusion, there is likely an opportunity cost. If, for example, the "MYCOSTATIN" product had been prescribed but a patient received the "NICOSTATIN" preparation for treatment of hyperlipidemia, the patient would not obtain relief of the symptoms attributed to the fungal infection, and the person might be one for whom the "NICOSTATIN" product is contraindicated. Similarly, a person seeking relief from an excess of lipids in the blood would obtain no relief if the "MYCOSTATIN" product rather than the "NICOSTATIN" product is inadvertently taken or administered.

However, applicant urges us to find that there would be no mistake or confusion based, in part, upon the fact that doctors [*14] will be prescribing the medicaments and pharmacists will be filling those prescriptions. Applicant also stresses that cardiologist will write many of the prescriptions for the NICOSTATIN preparation. Applicant argues that confusion will be avoided by expecting "... the exercise of ordinary care by sophisticated professionals." (Applicant's brief, p. 13). However, it is clear that general practice physicians would be writing prescriptions for both drugs. Furthermore, we should point out that specialized physicians and competent pharmacists are not infallible. The observations made years ago by Assistant Commissioner for Trademarks, Daphne Leeds, are also quite appropriate to recall at this juncture:

... physicians are not immune from confusion or mistake. Furthermore, it is common knowledge that many prescriptions are telephoned to the pharmacist and others are handwritten, and frequently the handwriting is not unmistakably legible. These facts enhance the chances of confusion or mistake by the pharmacist in filling the prescription if the marks appear too much alike when handwritten or sound too much alike when pronounced.

R. J. Strassenburgh Company v. Kenwood Laboratories, Inc., 106 USPQ 379, 380 [*15] (Com'r Pat 1955). Given these systemic weaknesses, even though the members of these professions are carefully trained to detect differences in the characteristics of pharmaceutical products, everyone involved in marketing ethical pharmaceuticals should want to avoid the adoption by drug manufacturers of trademarks which would be confusingly similar to anyone not exercising the greatest level of care. It should also be noted that these two prescription products might well be placed side-by-side in the patient's medicine cabinet, subject to the accidental substitution of one product for the other. Further, neither

identification is restricted to prescription medications, and today's "prescription only" preparation may be available over the counter at some later date. Hence, in the field of medicinal remedies, this Board and many federal courts are hesitant to speculate as to whether there is a sufficiently high probability of confusion between similar names. If there is a serious possibility of such confusion in the case of medicines, public policy requires that the use of the confusingly similar name be avoided. *See Morgenstern Chemical Company, Inc. v. G. D. Searle & Company*, 253 F.2d 390, 116 USPQ 480 (3rd Cir 1958) [*16] ["MICTINE" confusingly similar to "MICTURIN," and as in the instant case, this seminal case involves medicinal tablets taken orally for different ailments.]; *Glenwood Laboratories, Inc. v. American Home Products Corp.*, 455 F.2d 1384, 173 USPQ 19 (CCPA 1972) ["MYOCHOLINE" so resembles "MYSOLINE" that confusion is likely]; n7 *Syntex Laboratories, Inc. v. The Norwich Pharmacal Company*, 166 USPQ 312 (DC SNY 1970) ["VAGESTROL" and "VAGITROL" are so similar that their use on different prescription drugs is likely to cause confusion]; *Blansett Pharmacal Co. Inc. v. Carmrick Laboratories Inc.*, 25 USPQ2d 1473 (TTAB 1992) [Confusion likely between "NALEX" and "NOLEX" for pharmaceuticals]; *In re Star Pharmaceuticals, Inc.*, 221 USPQ 84 (TTAB 1984) ["STAR and design" v. "STARR and design" likely to cause confusion]; *American Home Products Corporation v. USV Pharmaceutical Corporation*, 190 USPQ 357 (TTAB 1976) ["PRESAMINE" so resembles "PREMARIN" that confusion is likely]; *In re Merck & Co., Inc.*, 189 USPQ 355, 356 (TTAB 1975) ["M-M-VAX" so similar to [*17] "M-VAC" that confusion is likely]; *Breon Laboratories Inc. v. Vargas*, 170 USPQ 532 (TTAB 1971) [Confusion likely between "BRONCO-FEDRIN" and "BRONKEPHRINE"].

n7 The late Judge Rich, in a dissenting opinion in *Glenwood Laboratories*, eschews the "extra care" doctrine in deliberations focused solely on registrability decisions in the U.S. Patent and Trademark Office. However, Judge Rich's premise back in 1972 is arguably no longer valid. With the advent in 1989 of an intent-to-use trademark system in the United States, pharmaceuticals companies, like applicant, can file for a trademark application much earlier in the FDA approval process and well prior to launching a product. Hence, unlike 1972, it will happen much less frequently that the junior party's look-alike or sound-alike mark is actually in use in the marketplace but is simply denied federal registration.

Accordingly, this *du Pont* factor also favors opposer.

Strength of opposer's mark:

We turn next to the renown of the "MYCOSTATIN" mark. The record shows that "MYCOSTATIN" preparations have been sold continuously in the United States since 1954. The sales of this [*18] preparation in its various forms have totaled \$ 100 million during the previous decade alone (e.g., from 1987 to 1996), with the anticipated millions of dollars in marketing and promotion commensurate with this level of sales. This objectifiable information about worldwide markets, extensive advertising and publicity, when combined with the nature of the information found in various medical reference books, periodicals and the popular press, all lead us to conclude that "MYCOSTATIN" is indeed a well-known mark.

Applicant would have us treat the renown of "MYCOSTATIN" as a liability in assessing likelihood of confusion, taking the position that:

If MYCOSTATIN is "famous" and well known, it is inconceivable that a physician would mistakenly prescribe the NICOSTATIN product for the treatment of a fungal infection... (Applicant's brief, p. 15)

However, the Lanham Act provides a broader range of protection as a mark's fame grows, and we are compelled herein to follow the proposition set forth by our primary reviewing Court that "the fifth *du Pont* factor, fame of the prior mark, plays a dominant role in cases featuring a famous or strong mark."

While scholars [*19] might debate as a factual proposition whether fame heightens or dulls the public's awareness of variances in marks, the legal proposition is beyond debate. The driving designs and origins

of the Lanham Act demand the standard consistently applied by this court--namely, more protection against confusion for famous marks.

Kenner Parker Toys Inc. v. Rose Art Industries Inc., 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992).

Accordingly, this *du Pont* factor also favors opposer.

Similar marks used by third parties:

In turning to the number and nature of similar marks in use on similar goods, the entirety of the record shows that the "myco-" prefix is used in a variety of nutritional food supplements, veterinary products, etc., but that opposer has successfully kept third parties planning to use similar formatives (e.g., MYOSTAT, MYCOSERT and MYCOSIN) from getting registrations for ethical pharmaceuticals. Accordingly, this *du Pont* factor also favors opposer.

No Actual Confusion:

Inasmuch as applicant has not filed an amendment alleging use, having evidently held off on initiating the commercial exploitation [*20] of this mark, the fact that there is no indication of any actual confusion herein is certainly to be expected. Hence, this factor favors neither party.

"MYCOSTATIN" is a product mark:

As to the variety of goods on which the MYCOSTATIN mark is being used, it is clearly a product mark, not a house mark, but it is, as noted above, prescribed in a variety of different settings in a range of forms.

No prior market interface:

The record discloses no market interface between applicant and opposer. In fact, several of opposer's witnesses were not aware of the existence of applicant until after the "NICOSTATIN" mark was published for opposition.

Opposer's success in eliminating similar marks:

We have noted above in our discussion on the number and nature of similar marks in use on similar goods, that applicant has demonstrated its success in excluding others from the use of similar marks on related goods. Accordingly, this *du Pont* factor also favors opposer.

Extent of potential confusion:

In determining the extent of potential confusion, we conclude that it is substantial. It is apparent from the foregoing that the sale [*21] of these two pharmaceutical preparations under confusingly similar marks could well result in confusion, and could also have serious consequences.

Finally, if after carefully reviewing all of the above *du Pont* factors, we still harbored any doubts about likelihood of confusion, this Board must resolve those doubts against the applicant, the newcomer herein. *Geigy Chemical v. Atlas Chemical Industry*, 438 F.2d 1005, 1008, 169 USPQ 39, 40 (CCPA 1971).

D. E. Bucher

C. M. Bottorff

L. K. McLeod

Administrative Trademark

Judges, Trademark Trial and Appeal Board

Legal Topics:

For related research and practice materials, see the following legal topics:

Trademark LawLikelihood of ConfusionConsumer ConfusionCircuit Court FactorsFederal Circuit CourtTrademark
LawProtection of RightsGeneral OverviewTrademark LawU.S. Trademark Trial & Appeal Board
ProceedingsOppositionsGrounds

Ex. E



Molenaar, Inc. v. Happy Toys Inc.

Opposition, No. 54,350, to application Serial No. 412,312, filed January 10, 1972.

Trademark Trial and Appeal Board

1975 TTAB LEXIS I

May 30, 1975, Decided

COUNSEL:

[*1]

L. Paul Burd, William A. Braddock, Richard O. Bartz and Robert W. Gutenkauf for Molenaar, Inc.

William T. Boland, Jr. and William J. Ungvarsky for Happy Toys Inc.

JUDGES: Before Leach, Waldstreicher and Lefkowitz, Members.

OPINION BY: Waldstreicher, Harry

OPINION:

Opinion by Waldstreicher, Member:

Happy Toys Inc. filed an application on January 10, 1972 to register "FINGER.MAGIC" (as illustrated below) for "building toys". Use since September 21, 1971 is alleged.

(SEE ILLUSTRATION IN ORIGINAL)

Registration is opposed by Molenaar, Inc. which alleged prior and continuous use of "RINGA MAJIGS" and design for building toys and ownership of Registration No. 942,313 covering that mark for "toys, namely, connectable members and blocks". n1

n1 Issued Sept. 5, 1972 on the basis of an application filed Oct. 12, 1971.

As grounds for opposition, opposer pleaded that the marks of the parties are applied to goods substantially identical in kind; that the marks of the parties are "confusingly similar"; and that confusion and mistake in the minds of the public are likely to occur from the concurrent use of applicant's mark "FINGER.MAGIC" for substantially identical goods.

Opposer filed testimony in [*2] its behalf and has also noticed its reliance on admissions made by applicant and on certain answers by applicant to interrogatories propounded by opposer. Applicant has not taken any testimony. Both parties have filed briefs.

Opposer is a manufacturer of toys and among the toys it manufactures and sells are building toys. The building toy is a plastic ring with four projections on the top side and four leg-like tubes on the bottom side. The toy is used in the manner of building blocks and all forms of towers can be built with these toys depending upon the imagination and dexterity of the child. The towers are put together by fitting the leg-like tubes to the projections. The effect is a tower of stools.

Opposer has been selling these building toys under the mark "RINGA MAJIGS" since 1966. During the period 1967 to sometime in 1971, "RINGA MAJIGS" building toys, and other of opposer's toys, were sold through its then exclusive manufacturers representative, M. I. Sales Co., Inc. For the year ending August 31, 1968, sales of "RINGA.MAJIGS" building toys exceeded \$ 195,000 and for the year ending August 31, 1969 sales of that product exceeded \$ 245,000. During the period September 1, 1969 through [*3] December 31, 1969 sales of "RINGA MAJIGS" building toys approximated \$ 130,000. During the calendar year 1970, sales were slightly more than \$ 266,000 but for the year thereafter, 1971, sales dropped to approximately \$ 176,500. In 1972 after M. I. Sales Co., Inc. ceased being opposer's sales representative, sales of "RINGA.MAJIGS" were only \$ 64,796.17 but sales for 1973 show an increasing trend. For the eleven months of 1973, sales exceeded \$ 97,000.

M. I. Sales Co., Inc. has not conducted any business since on or about September 16, 1971. Its officers since March 29, 1968 are the officers of the applicant corporation and have the same positions in applicant corporation. Applicant corporation and M. I. Sales Co., Inc. are located at the same address and M. I. Sales Co., Inc. was located at that address when it was actively acting as opposer's sales representative.

Applicant sells the same line of toys that M. I. Sales Co., Inc. sold for opposer. In announcing their entrance on the market as manufacturers, applicant advertised that it "is now manufacturing all of the toy items formerly carried by its sales division M. I. Sales Co., Inc." and that "We (applicant) are at the same [*4] location with the same people to serve your needs even better than before."

Applicant's building toy differs from opposer's building toy only in that it is octagonal rather than annular. Applicant has sold its building toys under the mark in issue to customers who have purchased from M. I. Sales Co., Inc. "RINGA.MAJIGS" building toys manufactured by opposer. Applicant's product under "FINGA MAGICS" was listed in the "S & H Green Stamps" premium catalogue issued in 1972. Previously, opposer's "RINGA MAJIGS" building toys had been included in the S & H catalogue.

Prior to the adoption and use of "FINGER-MAGIC", applicant had made a token use of "FINGA MAGICS" and had attempted to register that mark, claiming a first use of September 21, 1971. In the packaging of the toys, applicant uses a cylindrical container, as does opposer, and applicant uses the same stock numbers as the opposer.

Opposer received an order on October 17, 1972 for the purchase of 60 dozen containers of building toys, which was identified by applicant's mark "FINGER-MAGIC". This order was filled by opposer and the purchaser paid therefor. There is testimony that the same customer and other customers had ordered [*5] "FINGER-MAGIC".

The record also shows that an employee of counsel for opposer redeemed two books of "S & H GREEN STAMPS" for the item identified as "FINGA-MAGICS" construction set, and received opposer's product--"RINGA.MAJIGS" construction set. The catalogue, albeit illustrating packaging for applicant's goods, shows representations of what appear to be opposer's products.

There is no issue as to priority and it is clear that the products of the parties are directly competitive.

Phonetically, the marks of the parties (the design features of the respective marks are of little impression) are substantially similar. It is sufficient for the purposes of determining likelihood of confusion if the similarity between the marks is in sound alone. See: *Krim-Ko Corporation v. The Coca-Cola Company*, 156 USPQ 523 (CCPA, 1968).

It appears that the intention of the applicant was to get as close to opposer's mark as possible and it is our opinion

that it has succeeded to the extent that there is a likelihood of confusion. The record shows at least a single instance of actual confusion, albeit there is testimony which indicates that there have been more instances of actual confusion. [*6] While a single instance is insufficient as evidence from which to conclude that applicant's mark has consistently caused confusion, the single instance of confusion is at least "illustrative of a situation showing how and why confusion is likely". *Libbey-Owens-Ford Glass Company v. Thermoproof Glass Company*, 156 USPQ 510 (CCPA, 1968).

Decision:

The opposition is sustained, and registration to applicant is refused.

Legal Topics:

For related research and practice materials, see the following legal topics:

Trademark LawLikelihood of ConfusionSimilarityAppearance, Meaning & SoundSoundTrademark LawU.S.
Trademark Trial & Appeal Board ProceedingsOppositionsGrounds

GRAPHIC:

Illustration 1, no caption

Ex. F



In Re Merck & Co.

Opposition No. 63,456 to Application Serial No. 142,232, filed September 22, 1977.

NOTE: This opinion will not be published in full in a printed volume because it does not add significantly to the body of trademark law and is not considered to be of widespread legal interest. Thus, while the decision is a public record, it is not citable as precedent. A brief digest notation of the decision may appear in printed case reporter volumes.

Trademark Trial and Appeal Board

1982 TTAB LEXIS 35

April 27, 1992, Hearing

April 27, 1992, Decided

DISPOSITION:

[*1]

Decision: The opposition is sustained and registration to applicant is refused.

COUNSEL:

George H. Hopkins and Joanne L. Horn for Adria Laboratories Inc.

Offner and Kuhn for Reckitt & Colman (Overseas) Limited.

JUDGES: Before Fruge', Simms and Krugman, Members.

OPINION BY: Krugman, Gary D.

OPINION:

Opinion by Krugman, Member:

An application has been filed by Reckitt & Colman (Overseas) Limited to register "TEMGESIC" for pharmaceutical preparations, namely, analgesics. n1

n1 Application Serial No. 142,232 filed September 22, 1977 pursuant to Section 44(e) of the Trademark Act, based on United Kingdom Registration No. 1,062,367 issued May 4, 1976.

Registration has been opposed by Adria Laboratories Inc. on the ground that applicant's mark so resembles opposer's previously used and registered mark "TYMPAGESIC" for eardrops for human use n2 as to be likely, when applied to applicant's goods, to cause confusion, mistake or to deceive.

n2 Registration No. 720,578 issued August 29, 1961. Renewed.

Applicant, in its answer to the opposition, has denied the salient allegations therein.

The record consists of the pleadings, the file of applicant's application, opposer's pleaded registration [*2] made of record pursuant to Trademark Rule 2.122(c), opposer's notice of reliance on interrogatories and supplementalinterrogatories served upon applicant and applicant's answers thereto, opposer's notice of reliance on certain printed publications pursuant to Trademark Rule 2.122(c), opposer's notice of reliance on certain official records of the Patent and Trademark Office under Trademark Rule 2.122(c), applicant's notice of reliance on applicant's interrogatories served on opposer and opposer's answers thereto and on certain third-party registrations and printed publications, and testimony taken by opposer. Both parties have filed a brief on the case and opposer has filed a reply brief. Both parties were represented at the oral hearing.

Opposer's priority of use of the mark "TYMPAGESIC" for eardrops for human use has been established by virtue of opposer's pleaded registration. Accordingly, the question to be determined is whether the marks so resemble each other that, when they are applied to the respective goods, there would be a likelihood of confusion, mistake, or deception.

Opposer has, since 1953, manufactured and sold its eardrops for human use under the mark "TYMPAGESIC" [*3] and opposer continues to sell said eardrops. These goods have never been dispensed without a prescription. The goods are sold either to wholesalers who sell in turn to pharmacies, or are sold directly to pharmacies. Opposer's eardrops are also sold to hospitals and physicians. Opposer has, since 1975, averaged approximately \$200,000 per year in sales of the eardrops sold under the "TYMPAGESIC" mark. Opposer does not advertise its product in any journals or magazines but, rather, opposer advertises its product by way of listings in the Physicians' Desk Reference and similar reference books. Opposer also encloses an informational file card with each product.

Applicant's "TEMGESIC" analgesics, while not presently used in the United States, will be available only by prescription and will be used in hospitals under supervision of physicians.

Turning first to the respective goods of the parties, it is apparent that both of them are pharmaceutical preparations having analgesic properties. Applicant argues, however, that its product is administered by injection and through oral consumption while opposer's drug is poured into the ear canal; that opposer's drug is available through [*4] general prescription and is used by the patient himself while applicant's drug is available through limitedprescription and is used under supervision in hospital settings; and that opposer's drug is designed to alleviate minor pain in the ear canal whereas applicant's drug is designed for the alleviation of a significant threshold of pain experienced by cancer and heart attack patients and those having had a surgical operation, i.e., patients who would be receiving close medical attention. The difficulty with applicant's argument, however, is that neither its identification of goods nor that of opposer is limited as to how the drugs are sold or administered to the patient, or as to the type of pain the drugs are designed to alleviate. It is well settled that the question of likelihood of confusion in a proceeding such as this must be determined not on the basis of evidence which might have been adduced as to the nature and character of the goods, but rather on the basis of a comparison of the goods set forth in applicant's application vis-a-vis the goods recited in opposer's pleaded registration. See *Hecon Corporation v. Magnetic Video Corporation* 199 U.S.P.Q. 502 (TTAB 1978) [*5] and cases cited therein. Further, both applicant's goods and the goods of opposerare products which may be sold to pharmacies for resale to purchasers for the purpose of alleviating pain. Notwithstanding applicant's arguments about the differences in the uses of the respective products, there is nothing about the essential characteristics of these products that dictates the present distribution channels and the trade practices of the parties can be changed by either

party when economics or other factors dictate a need for such a change. See *Plus Products v. Redken Laboratories, Inc.* 199 U.S.P.Q. 111 (TTAB 1978) and cases cited therein. It is clear that both applicant's analgesics and opposer's eardrops could be purchased by the same wholesalers and pharmacists as well as by physicians and hospitals. While physicians and pharmacists are expected to exercise a high degree of care, they are not immune from confusion when the same or similar marks are used on the same or related goods. See *In re Merck & Co., Inc.*, 189 U.S.P.Q. 355 (TTAB 1975) and cases cited therein. The Board concludes, therefore, that the contemporaneous marketing of these goods under [*6] the same or similar marks would be likely to cause confusion.

Turning then to the respective marks of the parties, it is applicant's position that opposer's mark is merely descriptive, as applied to the goods, since it consists of the descriptive term "TYMPA", which refers to the tympanic membrane of the middle ear, combined with the descriptive term "GESIC", which is widely understood to refer to drugs having pain-killing or analgesic properties. However, as opposer has correctly pointed out, citing *Allied Mills, Inc. v. Kal Kan Foods, Inc.*, 203 U.S.P.Q. 390 (TTAB 1979), applicant's allegation that opposer's registered mark is merely descriptive is an impermissible attack on the validity of a valid and subsisting registration. Such an attack may not be entertained in the absence of a counterclaim to cancel said registration. Such a counterclaim has not been filed and it is further noted that opposer's registration is not subject to cancellation on the grounds that it is merely descriptive of the goods, in view of the fact that said registration is more than five years old. See 15 USC 1064.

Applicant has also introduced into the record copies [*7] of a number of registrations of marks employing the suffix "GESIC" and beginning with the letter "T" for drugs having analgesic properties. While these registrations may be probative to show that the Office has registered a number of marks containing the suffix "GESIC" for analgesics; that the parties herein as well as others in the field adopted marks containing the term "GESIC" to suggest the analgesic properties of their products; and that the inclusion of this term in two marks is, in and of itself, an insufficient basis upon which to bottom a finding of likelihood of confusion, said registrations are of little persuasive value on the specific question of whether the marks presented herein, when considered in their entirety, are so similar as to be likely to cause confusion as applied to the respective goods of the parties. See: *Spice Islands, Inc. v. Frank Tea & Spice Co.* 184 U.S.P.Q. 35 (CCPA 1974) and *Lone Star Mfg. Co., v. Bill Beasley, Inc.* 182 U.S.P.Q. 369 (CCPA 1974).

Comparing the marks "TEMGESIC" and "TYMPAGESIC" in their entirety, we believe that they are so similar in sound and appearance as to engender similar commercial impressions. [*8] While the specific differences in the marks are obvious upon a side-by-side comparison, the determination of likelihood of confusion is made not on the basis of a side-by-side comparison of the marks but, rather, on the basis of the overall commercial impression created by the respective marks in the mind of the consumer. See: *Glamorene Products Corporation v. Boyle-Midway, Inc., et al.*, 188 U.S.P.Q. 145 (DC SDNY 1975), *Sealed Air Corporation v. Scott Paper Company*, 190 U.S.P.Q. 106 (TTAB 1975), *American Home Products Corporation, et al. v. Johnson Chemical Co., Inc.* 200 U.S.P.Q. 417 (2nd Cir. 1978) and *L. Leichner (London) Limited v. Robbins*, 189 U.S.P.Q. 254 (TTAB 1975).

For the foregoing reasons, we conclude that applicant's mark "TEMGESIC" so resembles opposer's mark "TYMPAGESIC" as to be likely, when applied to the goods of the applicant, to cause confusion, mistake, or to deceive. n3 This is especially true in view of the fact that the products involved are medicines resulting in a stricter or higher standard of likelihood of confusion. See *Ethicon, Inv. v. American Cyanamid Company* 192 U.S.P.Q. 647 (TTAB 1976), [*9] *McLeod v. Hosmer-Dorrance, Inc., et al.*, 192 U.S.P.Q. 683 (DC ND Cal 1976) and cases cited therein.

n3 Opposer has also argued that applicant, during the ex parte prosecution of its application, made false statements to the Trademark Examining Attorney concerning opposer's channels of trade and classes of customers, in an attempt to have opposer's cited registration withdrawn as a reference. Opposer asserts that such misconduct gives rise to unclean hands. Inequitable conduct does not, in and of itself constitute a ground for refusal of registration in the absence of a showing that the conduct complained of amounted to fraud committed for the purpose of obtaining a registration which would not otherwise have been granted. Since neither applicant's goods nor the goods of opposer are limited as to the manner in which the products are sold and the

channels of trade through which they are sold, the statements made by applicant as to opposer's channels of trade and classes of customers were irrelevant, that is, it was the identification of the goods in the application and the registration that would be determinative of the question of likelihood of confusion. See *Hecon Corporation, supra*. Accordingly, it cannot be said with any certainty that applicant's statement resulted in the withdrawal of opposer's registration as a reference by the Examining Attorney and that such reference would not otherwise have been withdrawn. Under these circumstances, the Board declines to hold that applicant's conduct amounted to fraud.

[*10]

Legal Topics:

For related research and practice materials, see the following legal topics:

Trademark LawLikelihood of ConfusionGeneral OverviewTrademark LawProtection of
RightsRegistrationRenewalTrademark LawU.S. Trademark Trial & Appeal Board ProceedingsOppositionsGrounds

Ex. G

Post-Approval/Publication/Post-Notice of Allowance (NOA) Amendment

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	86020730
LAW OFFICE ASSIGNED	LAW OFFICE 104
MARK SECTION (no change)	
EXPLANATION OF FILING	
Applicant has entered into an Agreement whereby it agreed to delete the following goods from Class 5: Pharmaceutical products, namely, nutritional supplements, dietetic foods, namely, nutritional food bars and meal replacement shakes for weight loss purposes; dietary supplements for medical purposes; medical preparations for slimming purposes; appetite suppressants for medical purposes; and dietary fiber	
GOODS AND/OR SERVICES SECTION (001)(no change)	
GOODS AND/OR SERVICES SECTION (005)(current)	
INTERNATIONAL CLASS	005
DESCRIPTION	
Pharmaceutical products, namely, nutritional supplements, whey protein supplements; dietetic foods, namely, nutritional food bars and meal replacement shakes for weight loss purposes; food for babies, particularly milk and powdered milk for babies, infant milk; dietary supplements for medical purposes; medical preparations for slimming purposes; appetite suppressants for medical purposes; dietary fiber; lacteal flour for babies; malted milk beverages for medical purposes; dietetic sugar for medical purposes; dietetic sugar substitutes for medical purposes; sodium salt substitutes for dietetic or medical use; K-casein protein as dietary supplements	
FILING BASIS	Section 1(b)
GOODS AND/OR SERVICES SECTION (005)(proposed)	
INTERNATIONAL CLASS	005
TRACKED TEXT DESCRIPTION	
Pharmaceutical products, namely, nutritional supplements, whey protein supplements; <u>Whey protein supplements;</u> dietetic foods, namely, nutritional food bars and meal replacement shakes for weight loss purposes; food for babies, particularly milk and powdered milk for babies, infant milk; dietary supplements for medical purposes; lacteal flour for babies; medical preparations for slimming purposes; malted milk beverages for medical purposes; appetite suppressants for medical purposes; dietetic sugar	

for medical purposes; ~~dietary fiber~~; dietetic sugar substitutes for medical purposes; sodium salt substitutes for dietetic or medical use; K-casein protein as dietary supplements

FINAL DESCRIPTION

Whey protein supplements; food for babies, particularly milk and powdered milk for babies, infant milk; dietary supplements for medical purposes; lacteal flour for babies; malted milk beverages for medical purposes; dietetic sugar for medical purposes; dietetic sugar substitutes for medical purposes; sodium salt substitutes for dietetic or medical use; K-casein protein as dietary supplements

FILING BASIS

Section 1(b)

GOODS AND/OR SERVICES SECTION (029)(no change)**GOODS AND/OR SERVICES SECTION (030)(no change)****GOODS AND/OR SERVICES SECTION (031)(no change)****GOODS AND/OR SERVICES SECTION (032)(no change)****GOODS AND/OR SERVICES SECTION (035)(no change)****GOODS AND/OR SERVICES SECTION (042)(no change)****GOODS AND/OR SERVICES SECTION (043)(no change)****SIGNATURE SECTION****RESPONSE SIGNATURE**

/Julie B. Seyler/

SIGNATORY'S NAME

Julie B. Seyler

SIGNATORY'S POSITION

Attorney of record- NY Bar

SIGNATORY'S PHONE NUMBER

212-949-9022

DATE SIGNED

02/23/2015

AUTHORIZED SIGNATORY

YES

FILING INFORMATION SECTION**SUBMIT DATE**

Mon Feb 23 10:39:06 EST 2015

TEAS STAMP

USPTO/PPA-216.75.92.26-20
150223103906286232-860207
30-530dfccdb129208c7372ea
6529fe5bcde8942d1fd156676
7e39f617f07ad67273-N/A-N/
A-20150223102930389314

Post-Approval/Publication/Post-Notice of Allowance (NOA) Amendment To the Commissioner for Trademarks:

Application serial no. **86020730** has been amended as follows:

EXPLANATION OF FILING

Applicant has entered into an Agreement whereby it agreed to delete the following goods from Class 5: Pharmaceutical products, namely, nutritional supplements, dietetic foods, namely, nutritional food bars and meal replacement shakes for weight loss purposes; dietary supplements for medical purposes; medical preparations for slimming purposes; appetite suppressants for medical purposes; and dietary fiber

CLASSIFICATION AND LISTING OF GOODS/SERVICES

Applicant proposes to amend the following class of goods/services in the application:

Current: Class 005 for Pharmaceutical products, namely, nutritional supplements, whey protein supplements; dietetic foods, namely, nutritional food bars and meal replacement shakes for weight loss purposes; food for babies, particularly milk and powdered milk for babies, infant milk; dietary supplements for medical purposes; medical preparations for slimming purposes; appetite suppressants for medical purposes; dietary fiber; lacteal flour for babies; malted milk beverages for medical purposes; dietetic sugar for medical purposes; dietetic sugar substitutes for medical purposes; sodium salt substitutes for dietetic or medical use; K-casein protein as dietary supplements

Original Filing Basis:

Filing Basis: Section 1(b), Intent to Use: The applicant has had a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).

Proposed:

Tracked Text Description: ~~Pharmaceutical products, namely, nutritional supplements, whey protein supplements;~~ Whey protein supplements; ~~dietetic foods, namely, nutritional food bars and meal replacement shakes for weight loss purposes;~~ food for babies, particularly milk and powdered milk for babies, infant milk; dietary supplements for medical purposes; lacteal flour for babies; ~~medical preparations for slimming purposes;~~ malted milk beverages for medical purposes; ~~appetite suppressants for medical purposes;~~ dietetic sugar for medical purposes; ~~dietary fiber;~~ dietetic sugar substitutes for medical purposes; sodium salt substitutes for dietetic or medical use; K-casein protein as dietary supplements

Class 005 for Whey protein supplements; food for babies, particularly milk and powdered milk for babies, infant milk; dietary supplements for medical purposes; lacteal flour for babies; malted milk beverages for medical purposes; dietetic sugar for medical purposes; dietetic sugar substitutes for medical purposes; sodium salt substitutes for dietetic or medical use; K-casein protein as dietary supplements

Filing Basis: Section 1(b), Intent to Use: The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).

SIGNATURE(S)

Signature: /Julie B. Seyler/ Date: 02/23/2015

Signatory's Name: Julie B. Seyler

Signatory's Position: Attorney of record- NY Bar

Signatory's Phone Number: 212-949-9022

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

Serial Number: 86020730

Internet Transmission Date: Mon Feb 23 10:39:06 EST 2015

TEAS Stamp: USPTO/PPA-216.75.92.26-20150223103906286

232-86020730-530dfccdb129208c7372ea6529f

e5bcde8942d1fd1566767e39f617f07ad67273-N

/A-N/A-20150223102930389314

Generated on: This page was generated by TSDR on 2015-03-17 12:37:07 EDT

Mark: SAVELIANS

SAVELIANS

US Serial Number: 86020730

Application Filing Date: Jul. 26, 2013

Register: Principal

Mark Type: Trademark, Service Mark

Status: Application has been published for opposition. The opposition period begins on the date of publication.

Status Date: Mar. 11, 2015

Publication Date: Aug. 26, 2014

Mark Information

Mark Literal Elements: SAVELIANS

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

Goods and Services

Note: The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *...* identify additional (new) wording in the goods/services.

For: Ingredients for use in the manufacture of pharmaceutical and veterinary products, namely, excipients; lactose for use in the manufacture of pharmaceuticals

International Class(es): 001 - Primary Class

U.S Class(es): 001, 005, 006, 010, 026, 046

Class Status: ACTIVE

Basis: 1(b)

For: Whey protein supplements; food for babies, particularly milk and powdered milk for babies, infant milk; dietary supplements for medical purposes; lacteal flour for babies; malted milk beverages for medical purposes; dietetic sugar for medical purposes; dietetic sugar substitutes for medical purposes; sodium salt substitutes for dietetic or medical use; K-casein protein as dietary supplements

International Class(es): 005 - Primary Class

U.S Class(es): 006, 018, 044, 046, 051, 052

Class Status: ACTIVE

Basis: 1(b)

For: Meat and meat preparations, namely, preserved meats and sausages, processed meat, sliced meat; fish and fish preparations, namely, processed fish; poultry and game and poultry and game preparations, namely, poultry and game preserves; meat extracts; milk and milk products excluding ice cream, ice milk and frozen yogurt; cheese and cheese-based culinary preparations, namely, cheese dip, cheese food; butter; yoghurt; edible oils and fats; charcuterie products, namely, prepared meats; ham; salted meats and fish; crustaceans, not live; tinned meat and fish; milk-based beverages; milk desserts made predominantly of milk, fruit-flavored and containing fruit, namely, milk shakes; gelled milk; ready-made dishes based on meat, fish, poultry, game and cheese; charcuterie; ham; rillettes in the nature of meat pate, offal in the nature of meat intestines, black and white pudding; liver pâtés; fish mousses; sausages; prepared fish eggs; preparations for making soup and bouillon; tinned meat or fish, frozen, dehydrated and freeze-dried tinned food based on meat or fish; proteins for human consumption, namely, protein milk, milk serum, whey

International Class(es): 029 - Primary Class

U.S Class(es): 046

Class Status: ACTIVE

Basis: 1(b)

For: Coffee, tea, cocoa, chocolate and chocolate-based products, namely, chocolate confections, chocolate and chocolate-based ready to eat candies and snacks; cocoa products, namely, cocoa-based condiments and seasonings for food and drink; cocoa-and chocolate-based beverages; sugar, pastries and confectionery, namely, confectionery made of sugar; edible ices, ice cream and sherbets; coffee or chocolate desserts, namely, coffee or chocolate-based cookies, biscuits, pastries and cakes, chocolate fondue; milk desserts based on semolina, namely, semolina pudding, processed semolina based beverages with milk; chocolate milk desserts, namely, chocolate-based beverages with milk; pastry desserts, namely, clafoutis, babas, charlottes, custards, pies, puddings; sauces as condiments; ice; sandwiches, pizzas; rice-based ready-made dishes, pancakes; cookies; pastry; cakes; sweets; cheese sauce; custards; dessert crèmes based on milk or milk cream, namely, creamy puddings

International Class(es): 030 - Primary Class

U.S Class(es): 046

Class Status: ACTIVE

Basis: 1(b)

For: Animal foodstuffs; agricultural products not prepared, not transformed, namely, raw wheat; grains in the nature of unprocessed edible seeds; pet food; salt licks for cattle; raw cocoa beans; unprocessed cereal seeds; milk-based meal for animals; strengthening animal foodstuffs; foods derived from milk for cattle; grains for animal consumption

International Class(es): 031 - Primary Class

U.S Class(es): 001, 046

Class Status: ACTIVE

Basis: 1(b)

For: Mineral and aerated waters, syrups for beverages, fruit juices and other non-alcoholic beverages, namely, sodas, whey beverages, lemonades, vegetable juices, non-alcoholic aperitifs ; preparations for making beverages, namely, fruit drinks, whey drinks; essences for making non-alcoholic beverages; powders for effervescing beverages, namely, fruit drinks, whey drinks; isotonic beverages

International Class(es): 032 - Primary Class

U.S Class(es): 045, 046, 048

Class Status: ACTIVE

Basis: 1(b)

For: Business services, namely, business management assistance, business management and organization consultancy, business management consultancy, professional business consultancy, business efficiency advice, business information, business inquiries, business management, business administration, business investigations, commercial information agencies; rental of advertising space; on-line advertising on a computer network; organization of exhibitions for commercial or advertising purposes; commercial information and advice for consumers; retail services featuring foodstuffs, namely, online retail store and mail order services; promotional campaigns and advertising for commercial purposes

International Class(es): 035 - Primary Class

U.S Class(es): 100, 101, 102

Class Status: ACTIVE

Basis: 1(b)

For: Scientific and technological services, namely, analysis and testing in the field of food manufacturing conducted by engineers; services of analysis and industrial research, namely chemical analysis, analysis for implementation of computer systems, research and development of new products for third parties, biological research, research in bacteriology, research in chemistry, technical research in the field of food manufacturing; technical project studies in the field of food manufacturing; research in the field of environment protection; scientific and technical research in the field of food for humans and animals; quality control; scientific laboratories for food analysis; packaging design; professional consultancy in the field of development of new products and food substances conducted by engineers

International Class(es): 042 - Primary Class

U.S Class(es): 100, 101

Class Status: ACTIVE

Basis: 1(b)

For: Services for providing food and drink; catering services; home catering services; bar, café and cafeteria services

International Class(es): 043 - Primary Class

U.S Class(es): 100, 101

Class Status: ACTIVE

Basis: 1(b)

Basis Information (Case Level)

Filed Use: No

Currently Use: No

Amended Use: No

Filed ITU: Yes

Currently ITU: Yes

Amended ITU: No

Filed 44D: No

Currently 44D: No

Amended 44D: No

Filed 44E: No

Currently 44E: No

Amended 44E: No

Filed 66A: No

Currently 66A: No

Filed No Basis: No

Currently No Basis: No

Current Owner(s) Information

Owner Name: SB Alliance SNC

Owner Address: 42, rue Rieussec
78220 Viroflay
FRANCE

Legal Entity Type: CORPORATION

**State or Country Where
Organized:** FRANCE

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Lawrence E. Abelman

Docket Number: 876722

**Attorney Primary Email
Address:** fterranella@lawabel.com

**Attorney Email
Authorized:** Yes

Correspondent

**Correspondent
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ABELMAN FRAYNE & SCHWAB
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UNITED STATES

Phone: 2129499022

Fax: 2129499190

Correspondent e-mail: fterranella@lawabel.com

Correspondent e-mail Yes
Authorized:

Domestic Representative

Domestic Representative Name: Lawrence E. Abelman

Phone: 2129499022

Fax: 2129499190

Domestic Representative e-mail: fterranella@lawabel.com

Domestic Representative e-mail Yes
Authorized:

Prosecution History

Date	Description	Proceeding Number
Mar. 10, 2015	EXTENSION OF TIME TO OPPOSE PROCESS - TERMINATED	
Mar. 09, 2015	CHANGES/CORRECTIONS AFTER PUB APPROVAL ENTERED	67832
Mar. 09, 2015	ASSIGNED TO PETITION STAFF	67832
Feb. 23, 2015	TEAS POST PUBLICATION AMENDMENT RECEIVED	1111
Sep. 24, 2014	EXTENSION OF TIME TO OPPOSE RECEIVED	
Aug. 26, 2014	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
Aug. 26, 2014	PUBLISHED FOR OPPOSITION	
Aug. 06, 2014	NOTIFICATION OF NOTICE OF PUBLICATION E-MAILED	
Jul. 22, 2014	LAW OFFICE PUBLICATION REVIEW COMPLETED	73797
Jul. 16, 2014	APPROVED FOR PUB - PRINCIPAL REGISTER	
Jul. 16, 2014	EXAMINER'S AMENDMENT ENTERED	88888
Jul. 16, 2014	NOTIFICATION OF EXAMINERS AMENDMENT E-MAILED	6328
Jul. 16, 2014	EXAMINERS AMENDMENT E-MAILED	6328
Jul. 16, 2014	EXAMINERS AMENDMENT -WRITTEN	81854
Jul. 10, 2014	PREVIOUS ALLOWANCE COUNT WITHDRAWN	
Jun. 13, 2014	WITHDRAWN FROM PUB - OG REVIEW QUERY	76621
Jun. 04, 2014	LAW OFFICE PUBLICATION REVIEW COMPLETED	73797
Jun. 03, 2014	APPROVED FOR PUB - PRINCIPAL REGISTER	
May 27, 2014	TEAS/EMAIL CORRESPONDENCE ENTERED	88889
May 27, 2014	CORRESPONDENCE RECEIVED IN LAW OFFICE	88889
May 27, 2014	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Apr. 15, 2014	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
Apr. 15, 2014	NON-FINAL ACTION E-MAILED	6325
Apr. 15, 2014	NON-FINAL ACTION WRITTEN	81854
Mar. 25, 2014	APPLICANT AMENDMENT PRIOR TO EXAMINATION - ENTERED	73797
Mar. 20, 2014	ASSIGNED TO LIE	73797
Mar. 06, 2014	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Nov. 12, 2013	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
Nov. 12, 2013	NON-FINAL ACTION E-MAILED	6325
Nov. 12, 2013	NON-FINAL ACTION WRITTEN	81854
Nov. 09, 2013	ASSIGNED TO EXAMINER	81854
Jul. 31, 2013	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Jul. 30, 2013	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information

TM Attorney: FATHY, DOMINIC

Law Office Assigned: LAW OFFICE 104

File Location

Current Location: PUBLICATION AND ISSUE SECTION

Date in Location: Mar. 11, 2015

Proceedings

Summary

Number of Proceedings: 1

Type of Proceeding: Extension of Time

Proceeding Number: [86020730](#)

Filing Date: Sep 24, 2014

Status: Terminated

Status Date: Mar 10, 2015

Interlocutory Attorney:

Defendant

Name: SB Alliance SNC

Correspondent Address: LAWRENCE E. ABELMAN
ABELMAN FRAYNE & SCHWAB
666 3RD AVE FL 10
NEW YORK NY , 10017-4046

Associated marks

Mark	Application Status	Serial Number	Registration Number
SAVELIANS	Published For Opposition	86020730	

Potential Opposer(s)

Name: Forest Laboratories, LLC

Correspondent Address: Christopher Serbagi, Esq.
The Serbagi Law Firm, P.C.
488 Madison Avenue, Suite 1120
New York NY , 10022
UNITED STATES

Correspondent e-mail: ptoemails@earthlink.net , david@serbagilaw.com

Prosecution History

Entry Number	History Text	Date	Due Date
1	INCOMING - EXT TIME TO OPPOSE FILED	Sep 24, 2014	
2	EXTENSION OF TIME GRANTED	Sep 24, 2014	
3	INCOMING - EXT TIME TO OPPOSE FILED	Oct 23, 2014	
4	EXTENSION OF TIME GRANTED	Oct 23, 2014	
5	INCOMING - EXT TIME TO OPPOSE FILED	Dec 23, 2014	
6	EXTENSION OF TIME GRANTED	Dec 23, 2014	

Ex. H

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December 18, 2013

Via Email and Federal Express

Ashish D. Patel, Esq.

Thompson Hine LLP

Two Alliance Center, Suite 1600

Atlanta, Georgia 30326-4266

ash.patel@thompsonhine.com; ipdocket@thompsonhine.com

Re: SEBELA Trademark Application (Serial No. 86/127,398)

Dear Mr. Patel:

I am trademark counsel for Forest Laboratories, Inc. ("Forest"). It has come to our attention that your client, Sebela International Limited ("Sebela"), filed a federal intent-to-use application on November 22, 2013, for SEBELA, for "[m]edicated and pharmaceutical preparations, both prescription and over-the-counter, for use in dermatology; and, medicated and pharmaceutical preparations, both prescription and over-the-counter, for use in gastroenterology" in Class 5 (Serial No. 86/127,398). For the reasons discussed below, Forest requests that Sebela withdraw this application.

Forest owns the following federal registrations for the mark SAVELLA:

- 1) SAVELLA, for "pharmaceutical preparations for the treatment of fibromyalgia and neuropathic pain disorders" in Class 5 (Reg. No. 3,658,661), which Forest filed on June 21, 2007, and matured into a registration on July 21, 2009, and
- 2) SAVELLA and Design for "printed matter, namely, brochures, pamphlets, posters, newsletters, promotional materials, patient educational materials, all concerning the treatment of fibromyalgia and neuropathic pain disorders" in Class 16, and "medical informational services, namely, providing health information in the field of fibromyalgia and neuropathic pain disorders via a global computer network" in Class 44 (Reg. No. 3,761,078), which Forest filed on August 3, 2009, and matured into a registration on March 16, 2010.

Sebela's proposed mark SEBELA and Forest's SAVELLA marks are very similar in "sight, sound, and meaning," and both are filed in Class 5 for pharmaceutical preparations. The

CHRISTOPHER SERBAGI, ESQ.

respective marks look and sound virtually identical and have the same commercial impression. SEBELA contains the same first syllable, a very similar second syllable, and the same last syllable as SAVELLA. Forest's SAVELLA marks have priority because Forest filed its applications for those marks prior to the date when Sebela filed its application for SEBELA. Forest's mark SAVELLA has been in continuous and actual use since April 24, 2009, and its mark SAVELLA and Design has been in continuous and actual use in Class 16 since May 17, 2009, and in Class 44 since January 15, 2009.

Because both Forest and Sebela have an interest in preventing confusion, and since the danger to the public health resulting from such confusion is great, we are hopeful that Sebela will withdraw its application for SEBELA before it becomes too heavily invested in the mark and/or the parties expend unnecessary resources on this issue.

Please let me know how Sebela intends to proceed. Thank you for your consideration.

Very truly yours,



Christopher Serbagi

Ex. I

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of Application Serial No. 86/127,398
Mark: SEBELA

FOREST LABORATORIES, LLC,)	
)	
Opposer,)	Opposition No.: 91216969
)	
v.)	Serial No.: 86/127,398
)	
)	Trademark: SEBELA
SEBELA INTERNATIONAL LIMITED,)	
)	
)	
Applicant.)	

OPPOSER’S FIRST SET OF REQUESTS FOR ADMISSION TO APPLICANT

Pursuant to Trademark Rule of Practice Rule 2.120 and Federal Rule of Civil Procedure Rule 36, Opposer, Forest Laboratories, LLC (“Forest” or “Opposer”), hereby requests that Applicant, Sebela International Limited (“Sebela” or “Applicant”) admit or deny the truth of the following matters, including the genuineness of any documents identified herein.

DEFINITIONS AND INSTRUCTIONS

The following definitions are an integral part of each and every request, and are incorporated therein by reference:

1. Unless otherwise required by the context, the terms “You,” “Your,” or “Applicant” shall be understood to refer to Applicant, Sebela International Limited, its parent companies, subsidiaries, affiliates, related or controlled companies, predecessors in title and/or interest, including successors and assigns, and all persons employed by any and all of the

foregoing entities or individuals, including but not limited to attorneys, consultants, experts, investigators, agents, or other persons acting on behalf of or in concert with Applicant.

2. As used herein, “Applicant’s Mark” shall mean, and include, the mark SEBELA of Application Serial No. 86/127,398 alone, or in combination with any other words, symbols, graphics or designs as a trademark, service mark, trade name, corporate name or otherwise.

3. As used herein, “SAVELLA Marks” shall mean and include the marks, common law rights and/or registrations for the trademarks SAVELLA, SAVELLA and Design, any other mark which includes the word SAVELLA, or any mark which consists of or includes the design, image, or graphics, in any color, and specifically including inter alia the design marks as shown in Reg. No. 3,658,661 and Reg. No. 3,761,078.

4. Unless otherwise indicated, all requests are to be interpreted as activities in, directed to, or relate to the United States.

REQUESTS FOR ADMISSION

REQUEST FOR ADMISSION NO. 1:

Prior to Applicant’s selection of Applicant’s Mark, Applicant had actual knowledge of Opposer’s SAVELLA Marks.

REQUEST FOR ADMISSION NO. 2:

Prior to November 22, 2013, the filing date of the Applicant’s SEBELA Mark, Applicant had actual knowledge of Opposer’s SAVELLA Marks.

REQUEST FOR ADMISSION NO. 3:

Prior to Applicant’s selection of Applicant’s Mark, Applicant had actual knowledge of Opposer’s SAVELLA Marks and that the SAVELLA Marks were used in connection with pharmaceutical-related goods and services.

REQUEST FOR ADMISSION NO. 4:

Prior to November 22, 2013, Applicant had not conducted a trademark availability search for Applicant's Mark in connection with the goods set forth in U.S. Application Serial No. 86/127,398.

REQUEST FOR ADMISSION NO. 5:

Since November 22, 2013, Applicant has not conducted a trademark availability search for Applicant's Mark in preparation for use of the mark in the United States in connection with the goods set forth in U.S. Application Serial No. 86/127,398.

REQUEST FOR ADMISSION NO. 6:

Opposer's SAVELLA Marks were well-known prior to November 22, 2013.

REQUEST FOR ADMISSION NO. 7:

Applicant sells products that treat diseases and conditions associated with gastroenterology and dermatology.

REQUEST FOR ADMISSION NO. 8:

Applicant displays the mark SEBELA in capital letters on its web site.

REQUEST FOR ADMISSION NO. 9:

Applicant prominently displays the mark SEBELA on its web site.

REQUEST FOR ADMISSION NO. 10:

Applicant displays the mark SEBELA on its web site without any indication it is the company name of Applicant rather than the name of a product.

REQUEST FOR ADMISSION NO. 11:

Applicant uses the name SEBELA in its web site metatags to attract potential consumers of Applicant's products to its web site.

REQUEST FOR ADMISSION NO. 12:

There is no limitation in the goods set forth in U.S. Application Serial No. 86/127,398 that would indicate that Applicant intends to use SEBELA as a house mark, as opposed to a product name.

REQUEST FOR ADMISSION NO. 13:

There is no limitation set forth in U.S. Application Serial No. 86/127,398 that would limit the channels of trade.

REQUEST FOR ADMISSION NO. 14:

There is no limitation set forth in U.S. Application Serial No. 86/127,398 that would preclude Applicant from using SEBELA as the trade name for a prescription pharmaceutical product.

REQUEST FOR ADMISSION NO. 15:

If a pharmacist intended to prescribe SAVELLA but instead prescribed SEBELA, harm to the intended consumer of SAVELLA could result.

REQUEST FOR ADMISSION NO. 16:

If a pharmacist intended to prescribe SABELA but instead prescribed SAVELLA, harm to the intended consumer of SABELA could result.

REQUEST FOR ADMISSION NO. 17:

Prior to November 22, 2013, Applicant did not make use of its SEBELA Mark on or in connection with the goods set forth in that application in the United States.

REQUEST FOR ADMISSION NO. 18:

Prior to November 22, 2013, Applicant had not used its SEBELA Mark in test marketing in the United States.

REQUEST FOR ADMISSION NO. 19:

Prior to November 22, 2013, Applicant had not obtained or attempted to obtain any licenses or permits to sell or distribute the goods on which Applicant claims a *bona fide* intent to use, as set forth in that application in the United States.

REQUEST FOR ADMISSION NO. 20:

Prior to November 22, 2013, Applicant did not have any documents regarding specific planned use of its SEBELA Mark on or in connection with the goods set forth in U.S. Application Serial No. 86/127,398 in the United States.

REQUEST FOR ADMISSION NO. 21:

Prior to November 22, 2013, Applicant had not licensed or made an attempt to license its SEBELA Mark in the United States on or in connection with the goods set forth in U.S. Application Serial No. 86/127,398.

REQUEST FOR ADMISSION NO. 22:

Prior to November 22, 2013, Applicant had not created business plans to use Applicant's SEBELA Mark in the United States on or in connection with the goods set forth in that application.

REQUEST FOR ADMISSION NO. 23:

Since November 22, 2013, Applicant has not used its SEBELA Mark on or in connection with the goods set forth in that application.

REQUEST FOR ADMISSION NO. 24:

Since November 22, 2013, Applicant has not used its Sebela Mark in test marketing in the United States or in preparation for use in the United States.

REQUEST FOR ADMISSION NO. 25:

Since November 22, 2013, Applicant has not obtained or attempted to obtain any licenses or permits to sell or distribute the goods on which Applicant claims a *bona fide* intent to use, as set forth in that application.

REQUEST FOR ADMISSION NO. 26:

Since November 22, 2013, Applicant has not engaged in any correspondence that mentions specific planned use of its SEBELA Mark on or in connection with the goods set forth in that application.

REQUEST FOR ADMISSION NO. 27:

Since November 22, 2013, Applicant has not licensed or made an attempt to license its SEBELA Mark in the United States on or in connection with the goods set forth in that application.

REQUEST FOR ADMISSION NO. 28:

Since November 22, 2013, Applicant has not created business plans to use Applicant's SEBELA Mark in the United States on or in connection with the goods set forth in U.S. Application Serial No 86/127,398.

REQUEST FOR ADMISSION NO. 29:

Opposer's SAVELLA Marks have priority over Applicant's SEBELA Mark.

REQUEST FOR ADMISSION NO. 30:

Applicant has no reason to contest or disbelieve Opposer's position that it has been using its SAVELLA Marks continually and uninterrupted in commerce since the filing date of those respective applications.

REQUEST FOR ADMISSION NO. 31:

Applicant currently has no evidentiary or factual basis to assert that Opposer's SAVELLA registrations may be invalid, unenforceable, or subject to cancellation, in whole or in part.

THE SERBAGI LAW FIRM, P.C.
Attorney for Forest Laboratories, LLC.

Dated: December 8, 2014
New York, New York

/Christopher Serbagi/
Christopher Serbagi
488 Madison Avenue, Suite 1120
New York, New York 10022
Tele: (212) 593-2112
Fax: (212) 308-8582

CERTIFICATE OF SERVICE

I certify that a true and correct copy of the foregoing OPPOSER'S FIRST SET OF REQUESTS FOR ADMISSION TO APPLICANT is being served on Sebela International Limited, by electronic communication with deposit of same in the United States Mail, first class postage prepaid, in an envelope addressed to counsel for Applicant at:

Carrie Shufflebarger, Esq.
THOMPSON HINE LLP
10050 Innovation Dr.
Miamisburg, OH 45342-4931

/Christopher Serbagi/
Christopher Serbagi

Ex. J

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE
TRADEMARK TRIAL AND APPEAL BOARD**

In re: Application Serial No. 86/127,398

Mark: SEBELA

FOREST LABORATORIES, LLC,)	
)	
Opposer,)	
)	
v.)	Opposition No.: 91216969
)	
SEBELA INTERNATIONAL LIMITED,)	
)	
Applicant.)	

**APPLICANT’S OBJECTIONS AND RESPONSES TO
OPPOSER’S FIRST SET OF REQUESTS FOR ADMISSION**

Pursuant to Trademark Rule of Practice Rule 2.120 and Federal Rule of Civil Procedure Rule 36, Applicant Sebela International Limited (“Sebela” or “Applicant”) hereby submits its objections and responses to Opposer Forest Laboratories, LLC’s (“Forest” or “Opposer”) First Set of Requests for Admission (individually, “Request”, and collectively, “Requests”).

GENERAL OBJECTIONS

1. Applicant objects to the “Definitions and Instructions” to the extent they are overly broad, unduly burdensome, and inconsistent with or seek to impose obligations beyond those imposed by the Federal Rules of Civil Procedure. Applicant will respond in accordance with the applicable rules.

2. Applicant objects to Opposer’s Requests to the extent they require disclosure of information that is protected from discovery by the attorney-client privilege, work product doctrine, or any other privileges, doctrines or immunities. None of these responses, or any inadvertent disclosure of such information, is intended as, or should be construed as, a waiver or relinquishment of all or part of any applicable privilege or protection.

3. Applicant objects to Opposer’s Requests to the extent they seek information that is confidential, proprietary and/or trade secret, including, without limitation and by way of example, confidential research, development or commercial information. To the extent Applicant provides any responses to such Requests, such responses will be made pursuant to the terms of the Board’s Standard Protective Order or such other Stipulated Protective Order agreed to by the Parties and entered by the Board in this proceeding.

4. Applicant objects to each Request as unduly burdensome and oppressive to the extent that it purports to require Applicant to provide information that is beyond its immediate possession, custody or control.

5. Applicant objects to Opposer's Requests to the extent they seek information that is neither relevant to any claim or defense of any party to the proceeding nor reasonably calculated to lead to the discovery of admissible evidence, and as unduly burdensome and oppressive to the extent they purport to require Applicant to provide information that is beyond the scope of TTAB proceedings. By responding to Opposer's Requests, Applicant is not waiving any objection as to relevance of the information requested or otherwise provided.

6. Applicant objects to any Requests and "Definitions and Instructions" using terms or phrases such as "regarding," "relating to," "reflecting," "evidencing," "pertaining to," "concerning," and "referring or relating to", and "at least", as rendering the Requests and the "Definitions and Instructions" vague, overly broad, and thus unduly burdensome.

7. Applicant objects to any Request as unduly burdensome and oppressive to the extent any such Request is duplicative or redundant of other Requests.

8. Applicant objects to providing any information in response to any Requests or any portions thereof which are overly broad in scope from temporal and/or subject matter perspectives, and therefore unduly burdensome and/or not reasonably calculated to lead to the discovery of relevant or admissible evidence.

9. These objections are incorporated into each answer set out herein. To the extent that specific objections are cited in a specific response, those specific citations are provided because they are believed to be particularly applicable to that response, and should not be construed of a waiver of any of these general objections.

RESPONSES AND OBJECTIONS TO REQUESTS FOR ADMISSION

REQUEST FOR ADMISSION NO. 1:

Prior to Applicant's selection of Applicant's Mark, Applicant had actual knowledge of Opposer's SAVELLA Marks.

RESPONSE: Denied.

REQUEST FOR ADMISSION NO. 2:

Prior to November 22, 2013, the filing date of the Applicant's SEBELA Mark, Applicant had actual knowledge of Opposer's SAVELLA Marks.

RESPONSE: Admitted.

REQUEST FOR ADMISSION NO. 3:

Prior to Applicant's selection of Applicant's Mark, Applicant had actual knowledge of Opposer's SAVELLA Marks and that the SAVELLA Marks were used in connection with pharmaceutical-related goods and services.

RESPONSE: Denied.

REQUEST FOR ADMISSION NO. 4:

Prior to November 22, 2013, Applicant had not conducted a trademark availability search for Applicant's Mark in connection with the goods set forth in U.S. Application Serial No. 86/127,398.

RESPONSE: Denied.

REQUEST FOR ADMISSION NO. 5:

Since November 22, 2013, Applicant has not conducted a trademark availability search for Applicant's Mark in preparation for use of the mark in the United States in connection with the goods set forth in U.S. Application Serial No. 86/127,398.

RESPONSE: Admitted.

REQUEST FOR ADMISSION NO. 6:

Opposer's SAVELLA Marks were well-known prior to November 22, 2013.

RESPONSE: Applicant lacks sufficient information to either admit or deny the statement made in Request No. 6, and therefore denies same.

REQUEST FOR ADMISSION NO. 7:

Applicant sells products that treat diseases and conditions associated with gastroenterology and dermatology.

RESPONSE: Admitted.

REQUEST FOR ADMISSION NO. 8:

Applicant displays the mark SEBELA in capital letters on its web site.

RESPONSE: Admitted.

REQUEST FOR ADMISSION NO. 9:

Applicant prominently displays the mark SEBELA on its web site.

RESPONSE: Applicant objects to Request No. 9 insofar as the word “prominently” is vague, ambiguous, and undefined. Subject to and without waiving the foregoing specific objection or the General Objections hereof, Applicant admits it displays the mark SEBELA on its web site. Except as expressly admitted herein, Request No. 9 is denied.

REQUEST FOR ADMISSION NO. 10:

Applicant displays the mark SEBELA on its web site without any indication it is the company name of Applicant rather than the name of a product.

RESPONSE: Denied.

REQUEST FOR ADMISSION NO. 11:

Applicant uses the name SEBELA in its web site metatags to attract potential consumers of Applicant’s products to its web site.

RESPONSE: Applicant admits the name SEBELA appears in its website source code insofar as that term is included in the title of the site and in various URLs associated with pages on the site. Except as expressly admitted herein, Request No. 11 is denied.

REQUEST FOR ADMISSION NO. 12:

There is no limitation in the goods set forth in U.S. Application Serial No. 86/127,398 that would indicate that Applicant intends to use SEBELA as a house mark, as opposed to a product name.

RESPONSE: Admitted.

REQUEST FOR ADMISSION NO. 13:

There is no limitation set forth in U.S. Application Serial No. 86/127,398 that would limit the channels of trade.

RESPONSE: Applicant objects to Request No. 13 to the extent it suggests that a limitation in a Federal Registration affects a registrant’s rights to use the mark covered by the registration. Subject to and without waiving the foregoing specific objection or the General Objections hereof, Request No. 13 is denied.

REQUEST FOR ADMISSION NO. 14:

There is no limitation set forth in U.S. Application Serial No. 86/127,398 that would preclude Applicant from using SEBELA as the trade name for a prescription pharmaceutical product.

RESPONSE: Applicant objects to Request No. 14 to the extent it suggests that a limitation in a Federal Registration affects a registrant's rights to use the mark covered by the registration. Subject to and without waiving the foregoing specific objection or the General Objections hereof, Request No. 14 is denied.

REQUEST FOR ADMISSION NO. 15:

If a pharmacist intended to prescribe SAVELLA but instead prescribed SEBELA, harm to the intended consumer of SAVELLA could result.

RESPONSE: Applicant objects to Request No. 15 insofar as it calls for speculation on the part of Applicant, and insofar as the word "harm" is vague, ambiguous, and undefined. Subject to and without waiving the foregoing specific objections or the General Objections hereof, Applicant lacks sufficient information to either admit or deny Request No. 15, and therefore denies same.

REQUEST FOR ADMISSION NO. 16:

If a pharmacist intended to prescribe SABELA but instead prescribed SAVELLA, harm to the intended consumer of SABELA could result.

RESPONSE: Applicant objects to Request No. 16 insofar as "SABELA" is not a mark that is at issue in this proceeding, insofar as this request calls for speculation on the part of Applicant, and insofar as the word "harm" is vague, ambiguous, and undefined. Subject to and without waiving the foregoing specific objections or the General Objections hereof, Applicant lacks sufficient information to either admit or deny Request No. 16, and therefore denies same.

REQUEST FOR ADMISSION NO. 17:

Prior to November 22, 2013, Applicant did not make use of its SEBELA Mark on or in connection with the goods set forth in that application in the United States.

RESPONSE: Denied.

REQUEST FOR ADMISSION NO. 18:

Prior to November 22, 2013, Applicant had not used its SEBELA Mark in test marketing in the United States.

RESPONSE: Admitted.

REQUEST FOR ADMISSION NO. 19:

Prior to November 22, 2013, Applicant had not obtained or attempted to obtain any licenses or permits to sell or distribute the goods on which Applicant claims a *bona fide* intent to use, as set forth in that application in the United States.

RESPONSE: Denied.

REQUEST FOR ADMISSION NO. 20:

Prior to November 22, 2013, Applicant did not have any documents regarding specific planned use of its SEBELA Mark on or in connection with the goods set forth in U.S. Application Serial No. 86/127,398 in the United States.

RESPONSE: Denied.

REQUEST FOR ADMISSION NO. 21:

Prior to November 22, 2013, Applicant had not licensed or made an attempt to license its SEBELA Mark in the United States on or in connection with the goods set forth in U.S. Application Serial No. 86/127,398.

RESPONSE: Denied.

REQUEST FOR ADMISSION NO. 22:

Prior to November 22, 2013, Applicant had not created business plans to use Applicant's SEBELA Mark in the United States on or in connection with the goods set forth in that application.

RESPONSE: Denied.

REQUEST FOR ADMISSION NO. 23:

Since November 22, 2013, Applicant has not used its SEBELA Mark on or in connection with the goods set forth in that application.

RESPONSE: Denied.

REQUEST FOR ADMISSION NO. 24:

Since November 22, 2013, Applicant has not used its Sebela Mark in test marketing in the United States or in preparation for use in the United States.

RESPONSE: Admitted.

REQUEST FOR ADMISSION NO. 25:

Since November 22, 2013, Applicant has not obtained or attempted to obtain any licenses or permits to sell or distribute the goods on which Applicant claims a *bona fide* intent to use, as set forth in that application.

RESPONSE: Denied.

REQUEST FOR ADMISSION NO. 26:

Since November 22, 2013, Applicant has not engaged in any correspondence that mentions specific planned use of its SEBELA Mark on or in connection with the goods set forth in that application.

RESPONSE: Denied.

REQUEST FOR ADMISSION NO. 27:

Since November 22, 2013, Applicant has not licensed or made an attempt to license its SEBELA Mark in the United States on or in connection with the goods set forth in that application.

RESPONSE: Denied.

REQUEST FOR ADMISSION NO. 28:

Since November 22, 2013, Applicant has not created business plans to use Applicant's SEBELA Mark in the United States on or in connection with the goods set forth in U.S. Application Serial No 86/127,398.

RESPONSE: Denied.

REQUEST FOR ADMISSION NO. 29:

Opposer's SAVELLA Marks have priority over Applicant's SEBELA Mark.

RESPONSE: Applicant lacks sufficient information to either admit or deny the statement made in Request No. 29, and therefore denies same.

REQUEST FOR ADMISSION NO. 30:

Applicant has no reason to contest or disbelieve Opposer's position that it has been using its SAVELLA Marks continually and uninterrupted in commerce since the filing date of those respective applications.

RESPONSE: Applicant lacks sufficient information to either admit or deny the statement made in Request No. 30, and therefore denies same.

REQUEST NO. 31:

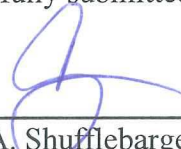
Applicant currently has no evidentiary or factual basis to assert that Opposer's SAVELLA registrations may be invalid, unenforceable, or subject to cancellation, in whole or in part.

RESPONSE: Applicant lacks sufficient information to either admit or deny the statement made in Request No. 31, and therefore denies same.

Signature follows:

Date: January 21, 2015

Respectfully submitted,



Carrie A. Shufflebarger
THOMPSON HINE, LLP
312 Walnut Street, Suite 1400
Cincinnati, Ohio 45202
(513) 352-6678
Carrie.Shufflebarger@ThompsonHine.com

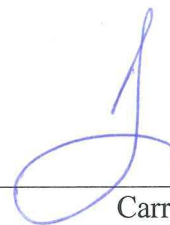
Ashish D. Patel
Thomson Hine LLP
Two Alliance Center
3560 Lenox Road NE, Suite 1600
Atlanta, Georgia 30326-4266
(404) 407.3607
ash.patel@thompsonhine.com

Attorneys for Applicant Sebela International Limited

CERTIFICATE OF SERVICE

I certify that a copy of the foregoing is being served via U.S. Mail and electronic mail on the following, this 21st day of January, 2015:

Christopher Serbagi
The Serbagi Law Firm PC
488 Madison Avenue
Suite 1120
New York, New York 10022



Carrie A. Shufflebarger

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE
TRADEMARK TRIAL AND APPEAL BOARD**

In re U.S. Trademark Application Serial No. 86/127,398 for “SEBELA” filed on November 22, 2013 and Published in the *Official Gazette* on April 22, 2014

FOREST LABORATORIES, LLC,)	
)	
Opposer,)	OPPOSITION NO.: 91216969
)	
v.)	
)	
)	
SEBELA INTERNATIONAL LIMITED,)	
)	
)	
Applicant.)	

DECLARATION OF PROFESSOR LISA DAVIDSON, PH.D.

I, Lisa Davidson, hereby declare as follows:

I am over the age of 18, competent to make this declaration, and I am familiar with the facts below. I offer this declaration in support of Opposer Forest Laboratories, LLC’s Motion for Summary Judgment.

1. I am an associate professor of linguistics at New York University specializing in phonetics. I received my BA degree in Linguistics and Hispanic Studies from Brown University and my MA and PhD in Cognitive Science from Johns Hopkins University.

2. My main research areas include the acoustic and articulatory characteristics of connected speech¹ production, the production and perception of non-native speech sounds, and ultrasound imaging of the tongue during speech. My work on the phonetics of connected speech, which is most relevant to the topic of this declaration, has been published in the peer-reviewed journals *Language*, *Phonetica*, *Speech Communication*, and the *Journal of the International*

¹ Connected speech is a continuous sequence of sounds forming utterances or conversations in spoken language.

Phonetic Association. I have also received funding from the National Science Foundation, including a 5-year CAREER award. I am currently an associate editor at *Laboratory Phonology* and on the editorial board of *Natural Language and Linguistic Theory*. Attached hereto as Exhibit A is a copy of my Curriculum Vitae.

3. This report addresses the similarities in pronunciation in the words SEBELA and SAVELLA. It is my opinion that the words SEBELA and SAVELLA are extremely likely to be confusable in connected speech. Despite differences in spelling, the pronunciation of these two words in nearly all dialects of American English could be potentially distinct in only one sound, but this distinction is almost always eradicated in connected speech, as described in more detail below.

4. The International Phonetic Alphabet (“IPA”) is a system for representing words in terms of their constituent sounds, independent of how they are actually written in English. Using the IPA, the intended pronunciations of these two words would be represented with the following symbols: SEBELA /sə**b**ɛlə/ versus SAVELLA /sə**v**ɛlə/. The bolded symbols highlight the only potential difference between the words. In these transcriptions, the schwa symbol /ə/ represents the short reduced vowel of English which is typically present when there is no stress or emphasis on a syllable (e.g., the first and last sounds in the word ‘America’ /əmɛrɪkə/). The vowel symbol /ɛ/ represents the ‘eh’ sound that is in the stressed syllable of both words, and the consonants /s/, /l/, /b/, and /v/ are similar to their letter correspondents.

5. A careful speaker of American English intending to distinguish these words would use their spelling (orthography) to pronounce one with a /b/ and one with a /v/. The sounds /b/ and /v/ are, however, similar both articulatorily (how they are produced in the mouth) and acoustically (how they sound to listeners), and are among the more confusable pairs of

English sounds even when they are precisely produced. Articulatorily, they are both in the class of “labial” sounds, indicating that the lips are involved in the execution of these sounds. In careful or clear speech, /b/ is a bilabial stop, which means that it is produced by bringing both lips together and obstructing the flow of air. During the period of lip closure of the stop sound, air builds up behind the obstruction; when the lip closure is released, a burst of air is produced. Thus, acoustically, a bilabial stop has two components: a period of silence, corresponding to when the lips are closed and no air is flowing out of the mouth, and a short burst of turbulent sound corresponding to the release of the lip closure. The sound /v/ is a labiodental fricative. In careful speech, it is produced by making a narrow channel between the top teeth and the bottom lip. This narrow opening usually causes turbulent air to be produced that lasts as long as the lip-to-teeth constriction is held. Acoustically, a fricative is heard as a period of turbulent or aperiodic sound (similar in nature to white noise, for example).

6. Though labial stops and fricatives would have distinct acoustic properties when they are produced in especially formal or clear speech, phonetic research has shown that in more casual speech, they are often produced with an indistinguishable acoustic signature. Both of these consonants are often weakened to a type of consonant called an approximant, which is produced at the same place of articulation as the corresponding stop or fricative, but with no obstruction of airflow at all. That is, neither the closure and burst of air that would be expected of a stop nor the turbulent sound characteristic of a fricative are regularly produced in American English casual speech. Instead, both sounds are produced as a labial approximant (symbolized in the IPA as /β/), which is a type of consonant that does not substantially restrict the airflow.

Research by Bouavichith and Davidson (2013)² and Warner and Tucker (2011)³ has shown that

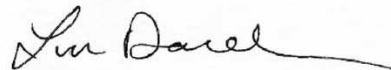
² Bouavichith, D. and L. Davidson (2013). “Segmental and prosodic effects on intervocalic voiced stop reduction in connected speech.” *Phonetica* 70(3): 182-206.

weakening of stops and fricatives in American English to an approximant within a word occurs in a variety of speech registers, ranging from read speech and broadcaster speech, which tend to be a little more formal, to conversational speech among friends. It has been hypothesized that this occurs because approximants require less articulatory effort than either stops or fricatives, and speakers often economize on articulatory effort if it does not impede comprehension.

7. In the case of SEBELA and SAVELLA, unless they are being directly compared to one another within the same spoken sentence, a speaker would have no reason to distinguish the pronunciation of these two words by producing a stop for SEBELA and a fricative for SAVELLA. Instead, both would likely be pronounced with an approximant as /səβɛlə/.

The matters stated in this declaration are true and accurate to the best of my personal knowledge. Pursuant to 28 U.S.C. § 1746, I declare under penalty of perjury under the laws of the United States that the foregoing is true and correct.

Dated: March 19, 2015
New York, New York



Prof. Lisa Davidson, Ph.D.

³ Warner, N. and B. Tucker (2011). "Phonetic variability of stops and flaps in spontaneous and careful speech." *Journal of the Acoustical Society of America* 130(3): 1606-1617.

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Declaration of Professor Lisa Davidson, Ph.D., has been served on Carrie Shufflebarger, Esq., attorney for Applicant, by mailing said copy on March 31, 2015, via First Class Mail, postage prepaid to:

Carrie Shufflebarger, Esq.
312 Walnut Street
Fourteenth Floor
Cincinnati, Ohio 45202



David Rome

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE
TRADEMARK TRIAL AND APPEAL BOARD**

In re U.S. Trademark Application Serial No. 86/127,398 for “SEBELA” filed on November 22, 2013 and Published in the *Official Gazette* on April 22, 2014

FOREST LABORATORIES, LLC,)	
)	
Opposer,)	OPPOSITION NO.: 91216969
)	
v.)	
)	
)	
SEBELA INTERNATIONAL LIMITED,)	
)	
)	
Applicant.)	

DECLARATION OF MICHAEL KUDERKA

I, Michael Kuderka, hereby declare as follows:

I am over the age of 18, competent to make this declaration, and I am familiar with the facts below. I offer this declaration in support of Opposer Forest Laboratories, LLC’s Motion for Summary Judgment.

1. I am the Executive Director of Marketing for Actavis Pharma, Inc., (“Actavis”) of which Opposer Forest Pharmaceuticals, LLC (“Opposer”) is an affiliated company.

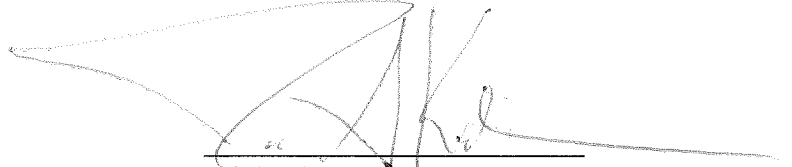
2. Forest’s SAVELLA® mark is extremely well-known. According to the IMS Health Inc. database, during 2014, total sales of the pharmaceutical Savella in the United States were \$133 million.

3. During that same time, Opposer, Opposer’s predecessor Forest Laboratories, Inc., and Actavis, expended more than \$2,000,000.00 on advertising in the United States.

The matters stated in this declaration are true and accurate to the best of my knowledge.

Pursuant to 28 U.S.C. §1746, I declare under penalty of perjury under the laws of the United States that the foregoing is true and correct.

Dated: 3.30, 2015
Jersey City, New Jersey



Michael Kudelka

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Declaration of Michael Kuderka, has been served on Carrie Shufflebarger, Esq., attorney for Applicant, by mailing said copy on March 31, 2015, via First Class Mail, postage prepaid to:

Carrie Shufflebarger, Esq.
312 Walnut Street
Fourteenth Floor
Cincinnati, Ohio 45202

A handwritten signature in black ink, appearing to read 'D. Rome', is written above a horizontal line.

David Rome